

**REMARKS**

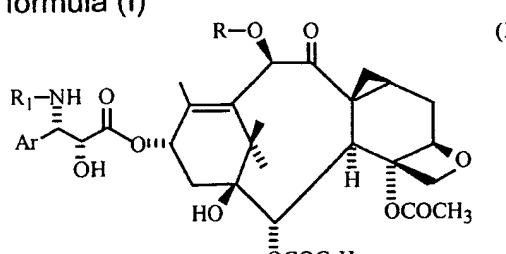
By this amendment, new claims 143-154 have been added and withdrawn claims 5-29, 54-78, and 103-139 have been cancelled. Claims 1-4, 30-53, and 79-102 were previously cancelled by an amendment filed April 20, 1995. Thus, claims 140-154 are left pending by this amendment.

**I. Support Under 35 U.S.C. § 112, First Paragraph**

Support for new claims 143-154 can be found in the originally filed specification. Support is described with specificity in Table 1, below. Solely for the Examiner's convenience, Applicants attach as Exhibit A, a certified English language translation of the French priority application, even though this translation has been submitted earlier in both *ex parte* prosecution and the interference.

**Table 1.**

Element	Support in Application 08/162,984	Support in French Priority Application No. 92/14,813
A method for treating breast cancer	Page 43, lines 20 to 28 which states "the pathological conditions include the abnormal cell proliferation of malignant or non-malignant cells of various tissues and/or organs . . ." See also page 43, line 27 to page 44, line 6 which states: "These pathological conditions can also include . . . cancers of the . . . breast . . ."	Page 33, lines 17 to 24 which states "the pathological conditions include the abnormal cell proliferation of malignant or non-malignant cells of various tissues and/or organs . . ." See also page 33, line 24 to page 34, line 3 which states: "These pathological conditions can also include . . . cancers of the . . . breast . . ."

administering to a human	Page 44, line 23 which states that the compounds are for "human or veterinary therapy."	Page 34, line 20 which states that the compounds are for "human or veterinary therapy."
an effective amount of a taxoid of formula (I)  in which R represents hydrogen or acetyl, R <sub>1</sub> represents benzoyl or R <sub>2</sub> -O-CO- in which R <sub>2</sub> represents t-butyl, and Ar represents phenyl or α- or β-naphthyl, said phenyl or naphthyl being unsubstituted or substituted by C <sub>1-4</sub> alkyl, C <sub>1-4</sub> alkoxy, halogen, or CF <sub>3</sub> , or Ar represents 2- or 3-thienyl or 2- or 3-furyl, said thienyl or furyl being unsubstituted or substituted by halogen.	Page 1, line 1 to page 2, line 23.	
A method for treating ovarian cancer	Page 43, line 27 to page 44, line 6 which states that "These pathological conditions can also include . . . cancers of the ovary . . . ."	Page 33, line 24 to page 34, line 3 which states that "These pathological conditions can also include . . . cancers of the ovary . . . ."
A method of treating melanoma	Page 43, line 27 to page 44, line 6 which states that "These pathological conditions can also include . . . melanomas . . . ."	Page 33, line 24 to page 34, line 3 which states that "These pathological conditions can also include . . . melanomas . . . ."

A method of treating colon cancer	Page 43, line 27 to page 44, line 6 which states that "These pathological conditions can also include . . . cancers of the . . . colon . . . ."	Page 33, line 24 to page 34, line 3 which states that "These pathological conditions can also include . . . cancers of the . . . colon . . . ."
A method of treating pancreatic cancer	Page 43, line 20 to line 27 which states that "The pathological conditions include abnormal cell proliferation of . . . [the] pancreas . . . ."	Page 33, line 17 to line 24 which states that "The pathological conditions include abnormal cell proliferation of . . . [the] pancreas . . . ."
A method of treating leukemia	Page 43, line 27 to page 44, line 6 which states that "These pathological conditions can also include . . . leukaemias . . . ."	Page 33, line 24 to page 34, line 3 which states that "These pathological conditions can also include . . . leukaemias . . . ."
an effective amount of $4\alpha$ -10 $\beta$ -diacetoxy-2 $\alpha$ -benzoyloxy-5 $\beta$ ,20-epoxy-1 $\beta$ -hydroxy-7 $\beta$ ,8 $\beta$ -methylene-9-oxo-19-nor-11-taxen-13 $\alpha$ -yl (2R,3S)-3-tert-butoxycarbonylamino-2-hydroxy-3-phenylpropionate.	Page 40, line 25 to page 41, line 1, describing the preparation of " $4\alpha$ -10 $\beta$ -diacetoxy-2 $\alpha$ -benzoyloxy-5 $\beta$ ,20-epoxy-1 $\beta$ -hydroxy-7 $\beta$ ,8 $\beta$ -methylene-9-oxo-19-nor-11-taxen-13 $\alpha$ -yl (2R,3S)-3-tert-butoxycarbonylamino-2-hydroxy-3-phenylpropionate."	Claim 3 at page 42, lines 11-15, disclosing four compounds, one of which is represented by $4\alpha$ -10 $\beta$ -diacetoxy-2 $\alpha$ -benzoyloxy-5 $\beta$ ,20-epoxy-1 $\beta$ -hydroxy-7 $\beta$ ,8 $\beta$ -methylene-9-oxo-19-nor-11-taxen-13 $\alpha$ -yl (2R,3S)-3-tert-butoxycarbonylamino-2-hydroxy-3-phenylpropionate. <sup>1</sup>

<sup>1</sup> See also the August 22, 1996 Decision by Administrative Patent Judge Mary F. Downey (Exhibit F), denying Junior Party Chen et al.'s motion to deny Bouchard benefit of the French priority document with respect to count 2 (claim 142,  $4\alpha$ -10 $\beta$ -diacetoxy-2 $\alpha$ -benzoyloxy-5 $\beta$ ,20-epoxy-1 $\beta$ -hydroxy-7 $\beta$ ,8 $\beta$ -methylene-9-oxo-19-nor-11-taxen-13 $\alpha$ -yl (2R,3S)-3-tert-butoxycarbonylamino-2-hydroxy-3-phenylpropionate). Judge Downey held that "[the] limited genus of four compounds is deemed sufficient (continued...)

Claims 140-142 were allowed in the May 23, 1995, Office action that preceded the declaration of the interference *Chen vs. Bouchard*, with Applicants being Bouchard. Claims 140-142 were respectively designated as corresponding to Counts 1-3 in the interference, which Counts are set forth in the October 2003, Federal Circuit decision. Again, solely for the Examiner's convenience, a copy of the Federal Circuit decision, setting forth the Counts is attached as Exhibit B.

Before the PTO Board of Patent Appeals and Interferences, Bouchard prevailed as to all of Counts 1-3 in the interference, a holding affirmed by the United States Court of Appeals for the Federal Circuit on October 22, 2003, in Chen's appeal of the Board's decision. The addition of claims 143-154 is consistent with both the original restriction requirement issued by Examiner Trinh on August 23, 1994, and the subsequent requirement of Examiner Peabody on January 23, 1995. Both requirements grouped the compound, composition, and method of treatment claims into a single group.

Claims 143-154 are method of treatment claims, directed to the use of the allowed product subject matter recited in claims 140 and 142, respectively. As set forth in M.P.E.P. 821.04, "when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of an amendment." Further, claims 143-154 are narrower in scope of use than issued

---

(...continued)

to satisfy 35 USC 112, first paragraph description requirement for the compound of count 2." Decision at 4. Thus, this issue of support for the species was expressly litigated in the interference, and Judge Downey's holding of written description for the species was not raised by Chen either at Final Hearing or before the Federal Circuit.

claim 9 of Chen's U.S. Patent No. 5,254,580 (the '580 patent), which was directed generally to treating mammalian tumors.

Neither the Board nor the Federal Circuit invalidated claim 9 in the *Chen v. Bouchard* interference except on the basis of priority. Reasons given by Bouchard in the interference attempting to invalidate claim 9 under 35 U.S.C. § 112, first paragraph, were never sustained and, in any event, do not apply to narrower claims 143-154.

Further, the earliest possible 35 U.S.C. § 102(e) filing date with respect to cyclopropyl subject matter of the '580 patent is March 11, 1993, the Federal Circuit having affirmed the Board's decision that Chen's July 1, 1992, and January 19, 1993, patent applications contained no written description of cyclopropyl subject matter. Table 1 set forth above demonstrates that each of claims 143-154 has full support under 35 U.S.C. § 112, first paragraph, in the French Priority Application No. 92/14,813, and thus the effective date for claims 143-154 is the December 9, 1992, filing date of the French Priority Application. The interference determined that claims 140-142 are also entitled to the December 9, 1992, filing date. Having an effective filing date of December 9, 1992, therefore, all of the claims 140-154 antedate the '580 patent.

Finally, as requested by the Examiner, Applicants include on the concurrently filed PTO form 1449 two articles which confirm that compositions from the taxane family are well known in the treatment of various cancer forms. In the enclosed articles, taxanes are recognized as being active against each of the claimed conditions breast cancer, ovarian cancer, pancreatic cancer, colon cancer, melanomas and leukemia.

Accordingly, Applicants request that the claims 143-154 be entered, as they are fully supported by the instant disclosure, and, like claims 140-142, are in condition for

immediate allowance by the Examiner.

## **II. Obviousness-type Double Patenting**

During a telephone conference with Examiner Trinh, he mentioned U.S. Patent No. 5,814,658 (the '658 patent) to Bouchard, which is assigned to the assignee of the instant application and which is a member of the same patent family as the present application. The PTO suspended prosecution in the '658 patent. On June 19, 1997, the '658 applicants faxed to Examiner Cross (later she took the name Examiner Lutz) a copy of each of the three counts of the interference along with a designation of which claims of Chen and Bouchard corresponded to each count. (Exhibit C). The Examiner acknowledged this fax in an August 5, 1997, Office Action (Exhibit D), concluding that there is no overlapping subject matter between the claims in the '658 patent prosecution and those of Chen and Bouchard in the patent interference. In other words, based on a full knowledge of the claims and counts in the interference, the PTO concluded that the claims that issued in the '658 patent are separately patentable, *i.e.*, patentably distinct, from claims 140-142.

There is also no double patenting regarding U.S. Patent No. 6,384,071 B2 (the '071 patent). The '071 patent issued from a divisional application, which was itself a child application of U.S. Patent Application 08/477,518, which matured into U.S. Patent the '658 patent. Specifically, attention is directed to claim 12, a method of treating a human or animal patient with at least one tumor exhibiting multi-drug resistance. The conclusion of patentable distinctness arrived at in the parent application '518 that

resulted in the '658 patent applies with equal force to claim 12 of the '071 patent, which is a method of using the compound recited in claim 1 of the '658 patent.

There are a number of other issued U.S. patents from the family of the present patent application. The undersigned discussed with the Examiner whether he desired copies of the other patents within this family that had been granted, also on subject matter that was designated via restriction requirement as separately patentable from the claims in the instant interference. Examiner Trinh indicated that Applicants need not produce copies of those references.

In investigating this matter, Applicants have determined that two patents, not part of the instant patent family, have been granted. The first was granted on a later developed "improved" use for a composition that overlaps with the scope of allowed claims 140 and 142, and the second was granted on a pharmaceutical composition containing a secondary treating agent and a composition that overlaps with the scope of allowed claims 140 and 142. Thus, Applicants bring to the Examiner's attention U.S. Patent Nos. 6,156,789 (the '789 patent) to Bissery et al. and 6,441,026 (the '026 patent) also to Bissery et al. The '789 patent is directed to a method of treatment based on the discovery that the compound of claim 142 has improved residence time in the brain. The '026 patent is directed to a pharmaceutical composition including a compound of claim 140 and at least one secondary treatment composition. Neither the '789 patent nor the '026 patent forms a basis for obviousness-type double patenting for the reasons set forth below. Applicants provide their analysis with reference to the '789 patent. The same analysis will then be applied to the '026.

A threshold issue is whether a one-way or two-way test is to be applied in assessing present issues of double patenting. Although the general rule is that a one-way test is applied, the present facts satisfy the exception articulated in *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991) and thus mandate application of a two-way test. Under the two-way test, it is irrelevant if claim 1 of the '789 patent would render unpatentable any of claims 140-154, considering either claim 1 to be "prior art" against claims 140-154 (one prong of the two-way test) as long as claim 1 of the patent is itself separately patentable over present claims 140-154, considering claims 140-154 to be prior art (the other prong of the two-way test). As will now be explained, the *Braat* two-way test controls, and claim 1 of the '789 patent is separately patentable over present claims 140-154, thus obviating any obviousness-type double patenting.

*Braat* recognized that while the rule against double patenting is to prevent unjustified timewise extensions of the patent right, in certain narrow instances, the extension of the right is justified. *Braat* and its predecessors grappled with the question of when double patenting should be established based solely upon a one-way test for distinctness and when it was necessary and/or justified to apply a two-way test for distinctness to achieve a fair result. *Braat* found that the two-way test should apply because the applicant could not have included the patent claims in the application, the inventors of the application differed from those of the patent, and it was not the assignee's fault that the patent issued first. *In re Braat*, 937 F.2d at 593-94.

The court in *In re Berg*, 140 F.3d 1428, 46 U.S. P.Q.2d 1226, (Fed. Cir. 1998), further addressed the *Braat* two-way/one-way question. In *Berg*, the Court stated that the one-way test should generally apply. They noted that the two-way test is an

exception and that "the two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application."

Even under the test in *Berg*, applicants qualify to have the two-way test of *Braat* applied. The application that formed the basis for the '789 patent and the instant application could not have been filed in a single application. The present application was filed in 1993, based on the discovery set forth in the December 9, 1992, priority application. The invention of the '789 patent, which was filed on March 7, 1998, was discovered subsequent to the filing of the instant application and names entirely different inventors. Thus, it is easy to conclude that in the present case, as in *Braat*, Applicants could not avoid separate filings.

Since separate filings were not at Applicants' discretion, the last hurdle for application of the *Braat* two-way test for distinctness to the present claims is to evaluate whether the rate of movement of the two applications, which controlled the order of issuance and led to the first issuance of the '789 patent, was controlled by the PTO. In the present case, the application has been pending for more than ten years, having been filed in the PTO on December 8, 1993. The extended pendency was not at the request of or controlled of the Applicants, as will now be explained.

Specifically, after Applicants filed the priority application in France in 1992 and shortly before Applicants filed the present application in the U.S. in December 1993, the '580 patent issued. After a restriction requirement issued in August 1994, Applicants filed a Request for Institution of an Interference and Amendment, followed by a

Preliminary Amendment. After Applicants filed a Supplemental Preliminary Amendment on December 29, 1994, the PTO issued two more restriction requirements on December 30, 1994, and January 23, 1995.

Applicants then changed to present counsel, who studied the file and on March 14, 1995, requested an interview. The interview was granted and held on April 13, 1995, after which Applicants filed another Amendment and Request for interference (an extension of time to respond to the Restriction requirement was also filed).

Following an Office Action dated May 23, 1995, suspending prosecution, the PTO (1) agreed with Applicants that there was interfering subject matter and declared an interference with Chen on October 24, 1995, (2) redeclared, on its own initiative, an interference on February 24, 1999, to add a third party, Hester, and (3) finally, on January 31, 2000, reformulated the single interference into three interferences: *Chen vs. Hester*, *Chen vs. Bouchard*, and *Hester vs. Bouchard*.

Hester conceded priority to Bouchard on all three counts, and Bouchard defeated Chen on all three counts, receiving a Board ruling of August 2, 2002, which, after Chen appealed, the Federal Circuit affirmed on October 22, 2003. Once Bouchard prevailed against both Chen and Hester, the *Chen vs. Hester* interference ended with judgment being entered against both parties. After all this, the present application was returned to the PTO in February 2004 for post-interference proceedings.

To be sure, Applicants requested some reasonable extensions of time during the interference and did not oppose reasonable requests for extensions of time by the opponents Chen and Hester. The interferences were complex, with extensive motion practice, as well as presentation of voluminous testimony by Chen in two of the

interferences that spanned many months over a period of years and involved the cross-examination of many witnesses.

Applicants have reviewed the lengthy interference files and determined that over the ten year pendency of the application and interference, Applicants and their opponents obtained some eleven months of extensions. Some six and one-half months of extension occurred before the March 17, 1998, filing date of the '789 patent, and some four and one-half months of extension occurred during the pendency of the prosecution resulting in the '789 patent.

Measured against the ten years of pendency, those reasonable extensions did not control the earlier issuance of the '789 patent. For example, at one point in the interference, the PTO took no action from July 28, 1997, until February 24, 1999, a time period spanning over a year and a half, during which period the application for the '789 patent was filed on March 17, 1998. And when the PTO did finally take action again, the PTO added the third party Hester, which led to very complex three way proceedings over the course of about a year until January 31, 2000, when, as noted above, the PTO then split the single three-party interference into three separate two party interferences.

Briefing in *Chen vs. Bouchard* during the PTO portion of the interference lasted until November 17, 2000, some three weeks before the '789 patent issued. Chen and Bouchard were not called to Final Hearing before the Board until May 16, 2001, almost six months after the '789 patent issued. After Final Hearing, the Board needed until August 2, 2002, to issue a heavily factually oriented decision in favor of Bouchard comprising more than one hundred pages. As explained above, Chen then appealed, extending resolution in favor of Bouchard until October 2003, almost three years after

the '789 patent issued. It then took the court about four months to return the Bouchard application to the Examiner for further proceedings.

These facts demonstrate that during the pendency of this application, including the eight year interference, Applicants have diligently prosecuted toward resolution of the outstanding issues.

As mentioned, Applicants do not assert that they did not avail themselves of necessary and reasonable statutory and PTO rule-based extensions of time. In view of the above explanation, however, any extension of time taken by Applicants or taken by opponents and not opposed by Applicants was clearly not controlling with respect to the rate at which of this application moved through the Patent and Trademark Office. It was the PTO that controlled the rate of prosecution, both *ex parte* and *inter partes*, that resulted in the later-filed '789 patent issuing earlier.

In summary, for the Examiner's convenience, Applicants include herewith as Exhibit E, a timeline detailing the prosecution of this application through the Patent Office, with the filing and issue dates of the '789 patent inserted therein. It is evident that the rate at which this application moved through prosecution was controlled by the PTO and the Federal Circuit. These circumstances qualify the present application for the *Braat* two-way test for obviousness-type double patenting.

*Braat*, to be sure, did not involve an interference. The facts of the present case, however, parallel the facts in *In re Stanley*, 214 F.2d 151, 102 U.S.P.Q. 234 (CCPA 1954), which did involve an interference and which also applied a two-way test. In that case, Stanley filed a patent application on October 2, 1943. On November 18, 1949,

the Examiner rejected the claims on a basis that led to an interference between the Stanley application and another patent.

On December 6, 1945, during the prosecution of the Stanley application, a commonly-owned Truitt application on an improvement to the invention disclosed in Stanley was filed. While the interference was pending, the Truitt application issued as a patent on July 4, 1950. The Interference proceeding was ultimately resolved after July 4, 1950.

When the *ex parte* prosecution of the Stanley application was resumed after termination of the interference, the Examiner rejected the claims of the Stanley invention over the claims of the Truitt patent based on double patenting. The Board affirmed the Examiner's decision rejecting the claims of the generic Stanley invention on the theory of double patenting, because the narrower improvement claims of Truitt issued before the generic invention and because both applications were assigned to the same party.

On appeal, the *Stanley* court reversed, determining that the claims in the improvement patent were patentably distinct when considered in view of the broader pending claim in the Stanley application. Thus, the *Stanley* court applied a two-way test for distinctness, the same test that should be applied to the present facts.

Because the two-way test applies, it is necessary to address whether the claims of the '789 patent are separately patentable over the instant claims. They are. The prosecution history of the '789 patent demonstrates that the '789 claim was allowed over a PCT published version of the disclosure of the present application, as well as family member U.S. Patent 5,580,998, which provides written description support for

each of claims 140-154. Hence, the PTO has already essentially ruled that the '789 claim is non-obvious over claims 140-154, and there is no issue of obviousness-type double patenting.<sup>2</sup>

Like the '789 patent, the subject matter of the '026 patent could not have been filed concurrently with the present application. The subject matter of the '026 application was filed on March 21, 2001, significantly after the present application and names different inventors, and reported work done subsequent to the 1992 and 1993 French and U.S. filing dates of the present application. Since the filing of a single application was not within applicants' discretion, for the reasons discussed *infra*, the *Braat* two-way test again applies to our analysis. Applying the two-way test, it is again necessary to address whether the claims of the '026 patent are separately patentable over the instant claims. They are. Obviousness-type double patenting is limited to a comparison of the claims of applications in issue, not their specifications. *In re Kaplan*, 789 F.2d 1574, 1580 (Fed. Cir. 1986). The claims of the instant application are limited to the compositions as set forth in claims 140 to 142 and the method of use of claims 143-154. Nothing within the claims of the instant application would teach or suggest the pharmaceutical compositions of the '026 patent including secondary treatment therapies. Thus, the claims of the '026 patent are non-obvious over claims 140-154, and there is no issue of obviousness-type double patenting.

---

<sup>2</sup> The PTO also necessarily ruled, in granting the claim of the '789 patent, that the claim was not inherently anticipated by either the '580 patent or applicant's disclosure. Even if that conclusion were challenged, it nonetheless remains that there is no issue of obviousness, since inherent subject matter is not relevant to the question of obviousness. See *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 757 (CCPA 1977).

Customer No. 22,852  
Attorney Docket No. 03806.0046-00000

**III. Conclusion**

As the Office has already determined the subject matter of claims 140-142 to be allowable and awarded priority to Applicants over the competing claims of both Chen and Hester, Applicants respectfully request the prompt allowance of method of use claims 143-154, which utilize the compounds of allowed claims 140 and 142.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

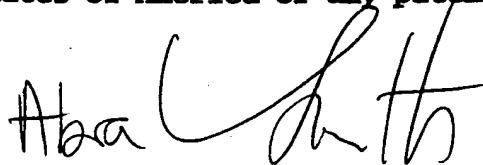
Dated: March 24, 2004

By: Evin C DeCarlo,  
Reg. No. 51,688 for  
Lori-Ann Johnson  
Reg. No. 34, 498

IN THE UNITED STATES PATENT OFFICE

I, Abraham SMITH, Dip.Ing., Dip.Doc.,  
translator to RWS Translations Ltd., of Europa House, Marsham  
Way, Gerrards Cross, Buckinghamshire, England declare;

1. That I am a resident of the United Kingdom of Great Britain and Northern Ireland.
2. That I am well acquainted with the French and English languages.
3. That the attached is, to the best of my knowledge and belief, a true translation into the English language of the accompanying copy of the specification filed with the application for a patent in France on 9 December 1992 under the number 92/14,813 and the official certificate attached hereto.
4. That I believe that all statements made herein of my own knowledge are true and that all statements made on information and belief are true; and further that these statements are made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardise the validity of the patent application in the United States of America or any patent issuing thereon.



For and on behalf of RWS Translations Ltd.

The 15th day of December 1993

FRENCH REPUBLIC

NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

P A T E N T S  
UTILITY CERTIFICATES - CERTIFICATES OF ADDITION

Official copy

The Director of the national Institute of industrial property certifies that the attached document is a true copy of an application for industrial property titleright filed at the Institute.

Drawn up in Paris, 28 JUNE 1993

On behalf of the Director of the  
National Institute of Industrial

Property

The Divisional Head

(signature)

Yves CAMPENON

NIIP

NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

26bis, rue de Saint-Pétersbourg 75800 PARIS Cédex 08

Tel.: (1) 42 94 52 52 Telex: 290 368 INPI PARIS Telefax: (1) 42 93 59 30  
National public establishment created by law No. 51-444 of 19 April 1951

BA 267/160692

United States Court of Appeals for the Federal Circuit

03-1037  
(Interference No. 103,675)

SHU-HUI CHEN and VITTORIO FARINA,

Appellants,

v.

HERVE BOUCHARD, JEAN-DOMINIQUE BOURZAT,  
and ALAIN COMMERCON,

Appellees.

Erroll B. Taylor, Fitzpatrick, Cella, Harper & Scinto, of New York, New York,  
argued for appellants. With him on the brief were Lisa B. Pensabene; and John W.  
Behringer, Fitzpatrick, Cella, Harper & Scinto, of Washington, DC.

Thomas L. Irving, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., of  
Washington, DC, argued for appellees. With him on the brief were Herbert H. Mintz,  
Timothy B. Donaldson, Sanya Sukduang, and Ester H. Lim. Of counsel on the brief  
was Ross J. Oehler, Aventis Pharmaceutical Inc., of Bridgewater, New Jersey.

Appealed from: United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences

# United States Court of Appeals for the Federal Circuit

03-1037

(Interference No. 103,675)

SHU-HUI CHEN and VITTORIO FARINA,

Appellants,

v.

HERVE BOUCHARD, JEAN-DOMINIQUE BOURZAT, and ALAIN COMMERCON,

Appellees.

---

DECIDED: October 22, 2003

---

Before NEWMAN, LOURIE, and SCHALL, Circuit Judges.

Opinion for the court filed by Circuit Judge LOURIE. Opinion dissenting in part filed by Circuit Judge NEWMAN.

LOURIE, Circuit Judge.

Shu-Hui Chen and Vittorio Farina (collectively "Chen") appeal from the decision of the United States Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences awarding judgment to appellees Hervé Bouchard, Jean-Dominique Bourzat, and Alain Commerçon (collectively "Bouchard"), the senior party, in Interference No. 103,675. Chen v. Bouchard, Inter. No. 103,675, Paper No. 336 (Bd. Pat. App. & Interfs. Aug. 2, 2002). Because the Board's decision was supported by substantial evidence and not contrary to law, and its evidentiary rulings do not reflect an abuse of discretion, we affirm.

## BACKGROUND

On October 24, 1995, the PTO declared the present interference between Chen's U.S. Patent 5,254,580, assigned to Bristol-Myers Squibb Company, and Bouchard's application U.S.S.N. 08/162,984, assigned to Rhône-Poulenc Rorer S.A. Id., slip op. at 1-2. The Chen patent issued from application U.S.S.N. 08/029,819, filed March 11, 1993, which was a continuation-in-part of application U.S.S.N. 08/006,423, filed January 19, 1993, which was in turn a continuation of application U.S.S.N. 07/907,261, filed July 1, 1992. The Bouchard application was filed December 8, 1993, and was accorded the benefit of the filing date of Bouchard's French application (No. 92 14813), filed December 9, 1992.

Chen's '261 application, entitled "Fluoro Taxols," was directed entirely to taxol derivatives and derivatives of baccatin III (a precursor of taxol) having fluorine in place of taxol's 7-hydroxy group, and described methods purportedly useful for the synthesis of those derivatives by fluorinating taxol derivatives with (diethylamino)sulfur trifluoride ("DAST"). Id. at 13-18. The application's claims were directed to those derivatives, pharmaceutical formulations containing them, and methods of using them to treat tumors. Id. at 18. The PTO allowed all of the claims in the '261 application in August 1992, just a month after the application was filed, and Chen paid the issue fee in November of that year. Id.

On January 19, 1993, Chen filed a petition to withdraw the '261 application from issuance, stating that it had been discovered that the methods described in that application did not produce mixtures of 7 $\alpha$ - and 7 $\beta$ -fluorotaxols, as had previously been believed, but instead produced mixtures of 7 $\alpha$ -fluorotaxols and 7,8-cyclopropataxols

(i.e., taxol derivatives in which taxol's 8-methyl group's carbon has displaced its 7-hydroxy group to form a fused three-membered ring). Id. at 18-19. Along with the petition to withdraw, Chen filed the '423 continuation application, pursuant to then-existing 37 C.F.R. § 1.60,<sup>1</sup> together with a preliminary amendment that cancelled all the original claims in the continuation application and added claims directed to cyclopropataxol and cyclopropabaccatin III derivatives. Id. at 19-20. Chen later filed another preliminary amendment to replace the β-fluorotaxols in the '423 application's drawings with drawings reflecting the cyclopropataxol structures. Id. at 20. A short time later, Chen filed the '819 CIP application, entitled "7,8-Cyclopropataxanes," claiming priority from both the '261 and the '423 applications and including a revised specification and claims to 7,8-cyclopropataxols, pharmaceutical formulations containing the same, a treatment method, and 7,8-cyclopropabaccatin III derivatives. Id. at 22.

The PTO thereafter rejected all of the new claims in the '423 continuation application under 35 U.S.C. § 112, ¶¶ 1 and 2, objected to the designation of that application as a "continuation," and objected to the second preliminary amendment under 35 U.S.C. § 132 as containing new matter. Id. at 21. Chen subsequently cancelled the claims in that application directed to the cyclopropataxol derivatives and intermediates useful for their synthesis, resulting in almost immediate allowance of the remaining claims, but later abandoned the application in favor of the '819 CIP

---

<sup>1</sup> "Rule 60," as 37 C.F.R. § 1.60 was commonly known, was repealed on October 10, 1997. See Changes to Patent Practice and Procedure, 62 Fed. Reg. 53,132, 53,188 (1997).

application. Id. The claims of the '819 application were also quickly allowed by the PTO, and the Chen patent issued from it on October 19, 1993. Id. at 22.

Like Chen's '819 CIP application, both the Bouchard application at issue in this interference and Bouchard's French priority application are directed to 7,8-cyclopropataxols.

There are three counts presently in this interference: 2, 3A, and 4. Count 2 corresponds to Chen's claims 7-9 and Bouchard's claim 142; Count 3A corresponds to Chen's claims 10-11 and Bouchard's claim 141; and Count 4 corresponds to Chen's claims 1-6 and 8-9 and Bouchard's claim 140. Id. at 6-7. Each of the three counts is written in the alternative, or "bifurcated," form. They read as follows:

Count 2

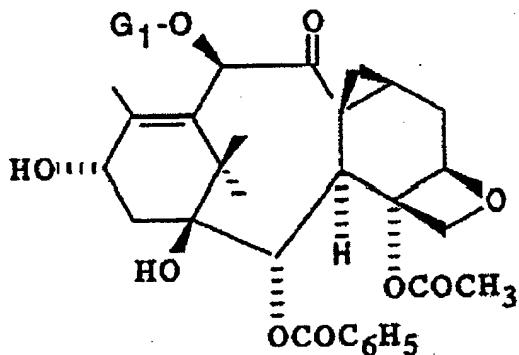
4 $\alpha$ -10 $\beta$ -diacetoxy-2 $\alpha$ -benzoyloxy-5 $\beta$ ,20-epoxy-1 $\beta$ -hydroxy-7 $\beta$ ,8 $\beta$ -methylene-9-oxo-19-nor-11-taxen-13 $\alpha$ -yl(2R,3S)-3-tert-butoxycarbonyl-amino-2-hydroxy-3-phenylpropionate

OR

N-debenzoyl-N-t-butoxycarbonyl-7-deoxy-8-desmethyl-7,8-cyclopropataxol.

Count 3A

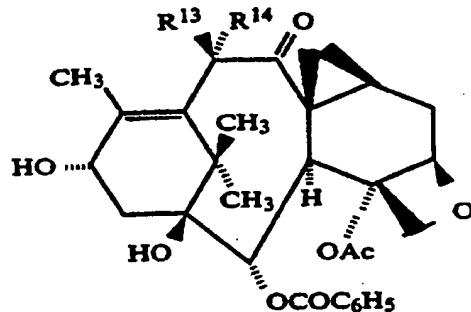
A taxoid of the formula:



in which G<sub>1</sub> represents hydrogen or acetyl,

OR

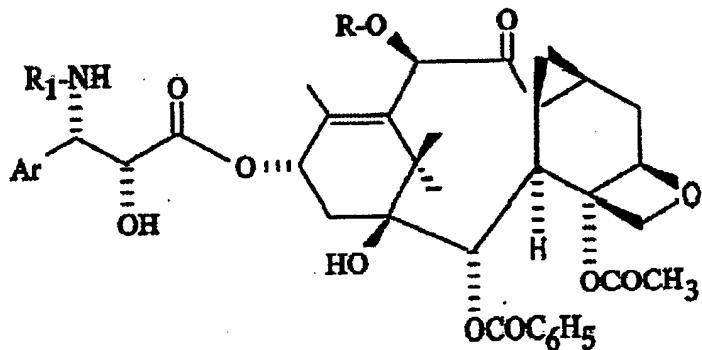
A compound of the formula:



in which  $R^{13}$  is hydrogen, acetoxy or hydroxy;  $R^{14}$  is hydrogen; or  $R^{13}$  and  $R^{14}$  jointly form a carbonyl group.

Count 4

A taxoid of the formula:



in which

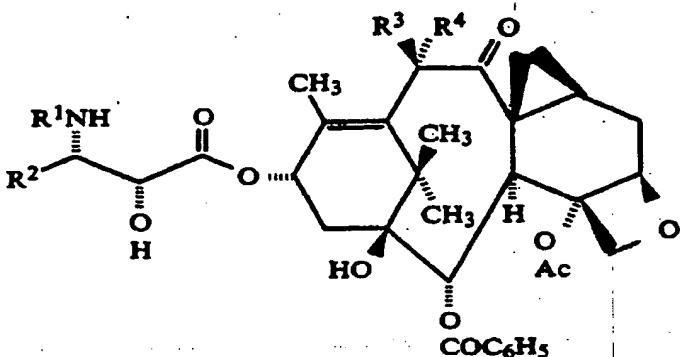
R represents hydrogen or acetyl,

$R_1$  represents benzoyl or  $R_2-O-CO-$  in which  $R_2$  represents t-butyl,  
and

Ar represents phenyl or  $\alpha$ - or  $\beta$ -naphthyl, said phenyl or naphthyl  
being unsubstituted or substituted by  $C_{1-4}$  alkyl,  $C_{1-4}$ -alkoxy, halogen, or  
 $CF_3$ , or Ar represents 2- or 3-thienyl or 2- or 3-furyl, said thienyl or furyl  
being unsubstituted or substituted by halogen,

OR

A compound of the formula[:]



in which

$R^1$  is  $-COR^2$  in which  $R^2$  is t-butyloxy,  $C_{1-4}$  alkyl,  $C_{2-6}$  alkenyl,  $C_{2-6}$  alkynyl,  $C_{3-6}$  cycloalkyl or phenyl, optionally substituted with one to three same or different  $C_{1-6}$  alkyl,  $C_{1-6}$  alkoxy, halogen or  $-CF_3$  groups;

$R^2$  is  $C_{1-6}$  alkyl,  $C_{1-6}$  alkenyl,  $C_{2-6}$  alkynyl,  $C_{3-6}$  cycloalkyl, or a radical of the formula  $-W-R^X$  in which  $W$  is a bond,  $C_{2-6}$  alkenediyl, or  $-(CH_2)_t-$ , in which  $t$  is one to six; and  $R^X$  is naphthyl, furyl, thienyl or phenyl, and furthermore  $R^X$  can be optionally substituted with one to three same or different  $C_{1-6}$  alkyl,  $C_{1-6}$  alkoxy, halogen or  $-CF_3$  groups; and

$R^3$  is  $OCOR$ ,  $-OCOOR$ ,  $H$ , or  $OH$ ;  $R^4$  is hydrogen; or  $R^3$  and  $R^4$  jointly form a carbonyl group; and  $R$  is  $C_{1-6}$  alkyl.

Both parties filed a number of motions over the course of the interference proceedings, most of which were denied or held to be moot by the Board in its very thorough opinion. See id. at 7-8, 35-48. The Board also chastised both parties for failing to state the legal theories on which they relied and for failing to specifically point out the location of the facts, if any, in the record that support the conclusory statements made by the parties. Id. at 10. Of primary importance, however, is the Board's denial of Chen's motion for the benefit of his '261 and '423 applications, making Chen the junior party and Bouchard the senior party. The Board held that Chen's earlier applications did not satisfy the written description requirement for any embodiment

within the counts. Id. at 25-26. The Board rejected Chen's argument that the cyclopropataxols of the count were inherently described by virtue of the fact that the methods described in the examples inevitably result in those compounds. Id. at 26-28, 32. The Board also distinguished various prior decisions cited by Chen, based on its reading of those cases as requiring submission of evidence supporting the proposed changes during prosecution, as well as evidence that the error would have been immediately recognized or readily discoverable by a person of ordinary skill in the art. Id. at 28-29, 32-33. The Board found that Chen provided no evidence of the discovery of his error prior to Bouchard's effective filing date, and that Chen had used a well-known fluorinating agent that one of ordinary skill would not have predicted would have resulted in cyclopropanation. Id. at 29.

The Board also granted Bouchard's motion to suppress as inadmissible hearsay the notebooks of a non-testifying witness and associated data proffered by Chen. Id. at 49-58. The Board rejected Chen's arguments that that evidence fell within either the "business records" exception (i.e., Fed. R. Evid. 803(6)) or the "catchall" exception (i.e., Fed. R. Evid. 807) to the hearsay rule, id. at 51-56, or that, although certain evidence may be hearsay, Bouchard waived any objections to the evidence by failing to follow the proper procedure for preserving his right to move to suppress that evidence, id. at 56-57.

Finally, the Board found that Chen's evidence of reduction to practice, or even conception, prior to the critical date was devoid of corroboration, id. at 72-80, and that Chen had failed to provide any corroborated evidence of diligence from just prior to the critical date until reduction to practice, id. at 80-109. The Board thus concluded that

Chen, as the presumptively junior party in this interference, had failed to meet his burden of demonstrating by a preponderance of the evidence either (1) that he actually reduced to practice the subject matter of the counts before Bouchard's effective filing date, or (2) that he conceived the invention before Bouchard's effective filing date and worked with reasonable diligence up to a constructive or actual reduction to practice. The Board then granted judgment in favor of Bouchard.

Chen now appeals. We have jurisdiction pursuant to 35 U.S.C. § 141 and 28 U.S.C. § 1295(a)(4)(A).

#### DISCUSSION

##### A. Entitlement to Priority

Whether a specification supports a claim corresponding to a count, and thus satisfies the written description requirement of 35 U.S.C. § 112, ¶ 1, is a question of fact, Vas-Cath v. Mahurkar, 935 F.2d 1555, 1562 (Fed. Cir. 1991), and is, in appeals from the PTO, reviewed under the substantial evidence standard, see In re Gartside, 203 F.3d 1305, 1315 (Fed. Cir. 2000) (holding that we review factual determinations underlying a legal conclusion that an invention is obvious under 35 U.S.C. § 103 using the substantial evidence standard).

Chen argues that the Board erred in concluding that he was not entitled to the benefit of the '261 and '423 applications as proof of his earlier conception and reduction to practice of the invention of the counts. Chen asserts that, although the '261 and '423 applications misidentified the resulting products, the methods described in those applications invariably produced compounds of the counts and therefore demonstrate his constructive reduction to practice. According to Chen, the case law makes it clear

that it is the product, not the formula or the name, that is the invention. There is no basis in the law, Chen argues, for requiring a patentee to prove that an error in a specification would have been apparent merely upon reading the specification at the time it was filed in order for the patentee to rely on that specification for proof of reduction to practice. Because, according to Chen, the products inherently had the structures called for by the count, it should not matter what the inventors initially thought the structures were or when the error was discovered, for there is no authority for requiring proof of inherency before grant.

Bouchard responds that the Board's decision was supported by substantial evidence: Chen did not describe any compounds of the counts in the '261 and '423 applications, and, for a party to be entitled to the benefit of an earlier application as a constructive reduction to practice of a count, the earlier disclosure must both describe the invention and enable one of ordinary skill in the art to make it; the '261 and '423 applications did not disclose by name, structure, or analytical characteristics any cyclopropataxol compound. Moreover, Bouchard argues, regardless whether the methods of the '261 application do inherently result in the production of cyclopropataxols, the nuclear magnetic resonance ("NMR") and mass spectrometry ("MS") data reported in that application correspond only to fluorotaxols and are inconsistent with cyclopropataxols; Chen later deleted those very data and added other data, corresponding to the cyclopropataxols, when he filed the '984 CIP application. According to Bouchard, Chen cannot possibly have "described" an invention in the '261 application that he had yet to conceive and in fact excluded from the application. Bouchard also contends that the prior cases cited by Chen are all inapposite, because

none of those cases involved an earlier-filed application that described an invention of compounds distinctly different from those later claimed. Rather, in each of the cited cases, the compound or product in question was conceived and essentially disclosed in one way or another at the time the application was filed.

We agree with Bouchard that the Board's decision denying Chen the benefit of his '261 and '423 applications was supported by substantial evidence. Not only did the Board find that there was no explicit disclosure of the compounds of the counts in Chen's priority applications, but it is also undisputed that the procedures described in those applications actually did produce some of the products actually described in the applications, namely the 7 $\alpha$ -fluorotaxol derivatives, which are not the invention involved in this appeal.

We also agree with Bouchard that the present case is readily distinguishable from all of the cases relied on by Chen. For example, in In re Nathan, 328 F.2d 1005 (CCPA 1964), the Board had affirmed a new matter rejection raised when the appellants sought to amend their specification and claims to indicate the steric orientation of the 2-halo groups in the claimed 2-halo steroids following a rejection for indefiniteness. In reversing the Board's decision, the court held that "the amendatory material . . . is concerned with an inherent characteristic of an illustrative product of appellants' invention already sufficiently identified in appellants' original disclosure as filed." Id. at 1009. Unlike in the present case, there was no incorrect structure disclosed in Nathan's originally filed application, but rather a structural formula lacking in a single detail. In that case, moreover, there was a disclosure of a definite melting point range, optical rotation, ultraviolet spectral analysis, and chemical analysis for the

product having the orientation that the appellant sought to add to the claim. The Board found no analogous disclosure in Chen's '261 and '423 applications.

In both In re Magerlein, 346 F.2d 609 (CCPA 1965), and Spero v. Ringold, 377 F.2d 652 (CCPA 1967), as in Nathan, the court found that the structures of the claimed compounds were correctly disclosed in the corresponding applications, the only deficiency being that the compounds' steric configurations were not specifically stated. Magerlein, 346 F.2d at 612; Spero, 377 F.2d at 656.

In Ex Parte Marsili, 214 USPQ 904 (Bd. Pat. App. & Interfs. 1979), a holding not binding on this court, the applicants initially disclosed that they had prepared compounds containing an imidazoline (also called a "dihydro-imidazole") ring, when in fact the described methods produced compounds having more stable, aromatic imidazole rings. In reversing a new matter rejection raised after the applicant sought to correct the structure in claim 1 of the patent application, the Board found that the question was not one of "adding characteristics not previously mentioned," but rather of "changing the original description of a product which . . . was described by sufficient characteristics to distinguish it." Id. at 905. The Board accordingly found that "the products described, exemplified and claimed by Appellants inherently had and have now the structure given in the amendment in question," and held that "the changes made in this amendment do not constitute new matter." Id. at 906. The '261 and '423 applications, in contrast, not only do not disclose the structural formulae of any cyclopropataxol derivatives, they apparently also do not disclose any analytical data or other characteristics of such derivatives.

In Reister v. Kendall, 159 F.2d 732 (CCPA 1947), the court affirmed a Board decision that a party to an interference was entitled to a prior filing date even though it had disclosed an erroneous structural formula for a claimed dye, where the asserted priority application sufficiently disclosed the subject matter of the counts even in view of the error. The Board had found in that case that the priority application "disclosed not only the complete process for preparing the dyestuffs but also the dyestuffs themselves and the means for identifying them that are called for by the counts." Id. at 733. In contrast, neither any cyclopropataxols nor any analytical data corresponding to cyclopropataxols were disclosed in Chen's earlier applications.

In Petisi v. Rennhard, 363 F.2d 903 (CCPA 1966), our predecessor court observed that "[t]he product, not the formula or name, is the invention." Likewise, in Regents of the University of New Mexico v. Knight, 321 F.3d 1111 (Fed. Cir. 2003), in the context of a case in which a district court had found that no new matter was added in an amendment correcting a structural formula because there was sufficient evidence to show that the added structure was an inherent and more accurate description of the disclosed subject matter, we recently wrote that "a chemical structure is simply a means of describing a compound; it is not the invention itself." Id. at 1122. Here, however, Chen did not simply misname or incorrectly illustrate the structural formula of the products that he later asserted were inherently produced; he also failed to disclose any characteristics of those products that would evidence possession of the invention. Indeed, others apparently of skill in the art even confirmed Chen's "identification" of the products as fluorotaxols, demonstrating that it was far from apparent that an error had been made, let alone that Chen had produced cyclopropataxol derivatives within the

scope of the counts. The fact that that result was "surprising" was further evidenced by Chen's later publication of an article entitled "Serendipitous Synthesis of a Cyclopropane-Containing Taxol" (emphasis added).

The evidence here is overwhelmingly one-sided. The Board found that neither of Chen's asserted priority applications literally "describes," in the sense of the patent statute, any compound within the scope of the counts in this interference. Rather, those applications describe obtaining only 7 $\alpha$ - and 7 $\beta$ -fluorotaxols and mixtures thereof, not 7,8-cyclopropataxols, and especially not 7,8-cyclopropataxols within any of the counts. Chen, slip op. at 25-26. The Board found, furthermore, that, at the time the '261 application was filed, the disclosure therein would have reasonably conveyed to one of skill in the art that fluorination of taxol with DAST, a known fluorination reagent, would have reasonably been expected from Chen's disclosure and from the knowledge possessed by an ordinarily skilled organic chemist at that time. Id. at 29-30. In fact, Chen's witness Dr. Kingston testified that the described reaction would have been expected to yield a 7-fluorotaxol at that time. The Board also found that, in contrast, there was no evidence that established that a person of ordinary skill in the art, reading the '261 application at the time it was filed, would have readily understood that instead of obtaining mixtures of 7-fluorotaxol, mixtures of 7-fluorotaxol and 7,8-cyclopropataxols would have resulted by performing the steps set forth in the examples. Id. at 33.

Indeed, Dr. Kadow, the Bristol-Myers Squibb researcher who repeated the examples of the '261 application in 1996 in order to demonstrate that those examples actually produced cyclopropataxols, testified that Chen would have reasonably interpreted the NMR spectrum for the compound that he produced to be a one-to-one

mixture of α- and β-epimers of 7-fluorotaxol, and that it was "reasonable" for Chen to have concluded that the NMR spectrum was consistent with a mixture of fluorotaxols. Id. at 30-31. It was against the backdrop of that evidence that the Board found that Chen's applications "would not have been recognized by a person of ordinary skill in the art at the time they were filed as 'describing' (in the sense of the statute) the compounds allegedly discovered by Chen et al. after they filed their applications." Id. at 31. Because that finding is supported by substantial evidence, we affirm the Board's conclusion that Chen's claims to the subject matter of the counts are not entitled to the benefit of the '261 and '423 applications' filing dates.

B. Hearsay

We review evidentiary rulings under an abuse of discretion standard. Kearns v. Chrysler Corp., 32 F.3d 1541, 1547 (Fed. Cir. 1994). Thus, we will not disturb the Board's evidentiary rulings unless the Board's decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) follows from a record that contains no evidence on which the Board could rationally base its decision. Gerritsen v. Shirai, 979 F.2d 1524, 1529 (Fed. Cir. 1992).

Chen argues that the Board erred by suppressing Jianmei Wei's notebooks and associated data, and additionally that Bouchard did not timely object to the excluded evidence. Moreover, according to Chen, the suppression of evidence was unreasonable, because, Chen asserts, the suppressed exhibits had been authenticated, and the Board suppressed an overly broad swath of testimony.

Bouchard responds that the Board's decision to suppress the evidence was justified: Chen chose not to call Dr. Wei as a witness despite her availability, and the Board has discretion to suppress evidence on its own volition.

We agree with Bouchard that Chen has failed to demonstrate that the Board abused its discretion in its evidentiary rulings. The Board took particular note of the fact that Wei, the author of the notebooks, was not called to testify. The Board also properly concluded, on the basis of its quite thorough analysis, that Wei's notebooks do not fall within the "business records" exception<sup>2</sup> or the "catchall" exception<sup>3</sup> to the hearsay rule. Moreover, regardless whether Bouchard failed to timely move to

---

<sup>2</sup> The so-called "business records" exception to the hearsay rule, Fed. R. Evid. 803(6), at all times relevant to this interference, read as follows:

The following are not excluded by the hearsay rule, even though the declarant is available as a witness: . . .

(6) Records of regularly conducted activity. A memorandum, report, record, or data compilation, in any form, of acts, events, conditions, opinions, or diagnoses, made at or near the time by, or from information transmitted by, a person with knowledge, if kept in the course of a regularly conducted business activity, and if it was the regular practice of that business activity to make the memorandum, report, record or data compilation, all as shown by the testimony of the custodian or other qualified witness, unless the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Because Chen presented no testimony from the "custodian or other qualified witness" that Wei's notebooks were "records of regularly conducted activity," relying instead only on Chen's uncorroborated testimony, the Board properly concluded that those notebooks did not fall within the purview of the exception.

<sup>3</sup> In relevant part, the "catch-all" exception, Fed. R. Evid. 807, reads as follows:

A statement not specifically covered by Rule 803 or 804 but having equivalent circumstantial guarantees of trustworthiness, is not excluded by the hearsay rule . . . .

Because the Board found that Chen offered no evidence of the "circumstantial guarantees of trustworthiness" other than the very documents of Wei that Bouchard sought to exclude, the Board properly concluded that those documents also do not fall within this exception.

suppress certain evidence, the Board has authority under 37 C.F.R. § 1.655(a) to choose not to consider hearsay evidence. While notebook records are obviously of prime importance in proving the elements of invention, the failure of the notebooks' alleged author to testify; the fact that it was not established on the record that those notebooks were actually the notebooks of Wei, except by the circular testimony of Chen, whose activity was what was intended to be corroborated by the notebooks; and the lack of evidence of Bristol-Myers Squibb's policies regarding maintenance of laboratory notebooks, all compel affirmation of the Board's decision to exclude the notebooks, under our abuse of discretion standard. We therefore affirm the Board's evidentiary rulings.

C. Reduction to Practice or Conception Plus Diligence

For Chen to prevail in this interference as the junior party, he would have had to have established by a preponderance of the evidence either that he actually reduced to practice the subject matter of the counts before Bouchard's effective filing date or that he had conceived the subject matter of the counts before Bouchard's effective filing date, and followed up with reasonable diligence from just prior to Bouchard's effective filing date up to his own constructive or actual reduction to practice.

Chen contends that the Board erred in concluding that he did not meet his burden of showing that he had conceived any compounds within the counts prior to the critical date. According to Chen, evidence was adduced showing that BMS-183582 and BMS-183821, which were recognized from the start to be cyclopropataxols of Counts 3A and 4, were actually reduced to practice from "7-epi" starting materials before the critical date, even though those syntheses were first disclosed in the '819 application.

Chen argues that the identity of those compounds was confirmed by NMR, MS, and x-ray crystallographic analysis by non-inventors prior to the critical date, and that the Board applied an incorrect legal standard of corroboration in making its determination that Chen failed to prove actual reduction to practice. Chen contends that confirmation tests need not be definitive; reasonable certainty is the standard. According to Chen, the Board also erred by holding that structure-confirmation tests by non-inventors are disqualified from serving as corroborating evidence if, as here, the inventor told the non-inventors what he thought the test would show.

Bouchard responds that Chen has provided no corroborating evidence of conception or diligence in reduction to practice. According to Bouchard, cyclopropataxols were unexpected reaction products with a high potential for misidentification during analysis. Bouchard also contends that NMR and MS are unreliable for identifying previously unknown complex molecules, especially when those compounds are in mixtures, and no non-inventor witnesses contemporaneously interpreted the key spectra relied on by Chen. Bouchard points out that Chen's witness Qi Gao, a Senior Research Investigator at Bristol-Myers Squibb, testified that she solved the crystal structure of a cyclopropataxol given to her by Chen prior to the critical date, but did not explain how the x-ray data were obtained or how they demonstrate a cyclopropataxol structure. Like NMR spectra, x-ray diffraction data are capable of multiple interpretations and are not self-proving, according to Bouchard.

It is well established that when a party seeks to prove conception via the oral testimony of a putative inventor, the party must proffer evidence corroborating that testimony. See Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577 (Fed. Cir. 1996); Price

v. Symsek, 988 F.2d 1187, 1194 (Fed. Cir. 1993). That rule addresses the concern that a party claiming inventorship might be tempted to describe his actions in an unjustifiably self-serving manner in order to obtain a patent or to maintain an existing patent. See Eibel Process Co. v. Minn. & Ont. Paper Co., 261 U.S. 45, 60 (1923); Kridl v. McCormick, 105 F.3d 1446, 1450 (Fed. Cir. 1997) ("The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony."); Price, 988 F.2d at 1194-95. There is no particular formula that an inventor must follow in providing corroboration of his testimony of conception. See Kridl, 105 F.3d at 1450. Rather, whether a putative inventor's testimony has been sufficiently corroborated is determined by a "rule of reason" analysis, in which "an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached." Price, 988 F.2d at 1195. However, that "rule of reason" analysis does not alter the requirement of corroboration of an inventor's testimony. Brown v. Barbacid, 276 F.3d 1327, 1335 (Fed. Cir. 2002). Evidence of the inventive facts must not rest alone on the testimony of the inventor himself. Cooper v. Goldfarb, 154 F.3d 1321, 1330 (Fed. Cir. 1998).

As an initial matter, we agree with Chen that the Board erred by setting forth an incorrect standard for evaluating corroborating evidence. The Board stated that

Chen et al.'s evidence does establish that samples of compounds prepared by Dr. Chen were forwarded to the analytical section of Bristol-Myers Squibb's laboratory in Wallington, Connecticut, by Dr. Chen for analysis. But in each instance Dr. Chen provided the analytical section with a structural formula of the compound he believed he had prepared.

Dr. Chen did not give the analytical section an unknown sample and request a determination of its structure by the analytical section. Thus, the analytical section's alleged "confirmation" of the structure

provided to them by Chen cannot establish, independently of Dr. Chen's proposed formula, what was the identity of the compound produced because Dr. Chen provided them with the structure he believed the compound possessed in advance. Frilette v. Kimberlin, 412 F.2d 1390, 1398, 162 USPQ 148, 155 (CCPA 1969).

Chen, slip op. at 74-75. The Board further stated that

Ms. Huang's conclusion that the spectra she obtained were "consistent" with Dr. Chen's proposed structure and Dr. Kingston's after the fact conclusion that the spectra obtained were "consistent" with Dr. Chen's proposed structure are not independent analysis or even knowledge independent of Dr. Chen because each relied on Dr. Chen's proposed structure for purposes of their analysis. Frilette v. Kimberlin, supra.

Id. at 97-98. Finally, the Board noted that,

rather than analyze the samples Dr. Chen gave to the analytical group to determine without the benefit of any prior suggestion of what the compound tested actually was, the analytical group was merely running NMR analyses on the samples and reviewing the samples for evidence that Dr. Chen's proposed structure for the compounds was "consistent" with the NMR spectra.

Id. at 108.

To the extent that the Board's statements quoted above suggest that an analytical chemist must be "kept in the dark" as to what an inventor believes a submitted compound's structure is in order for that chemist's later testimony to have corroborative value, the Board is mistaken. Neither the Frilette decision cited by the Board nor any other decision of this court or our predecessor courts requires as much.

In the relevant part of Frilette, that decision simply held that:

[T]he designation of the material involved in the . . . tests in [appellant's witness] Lago's records as "Linde Molecular Sieve 13X calcined ammonium exchange" cannot establish identification since that designation was merely copied by Lago from the label on the bottle in which the sample was given to him by Frilette and was not based on either knowledge or analysis by Lago.

412 F.2d at 1398. The dispositive fact in that case, as we understand it, was not that Lago obtained the molecular sieves from a labeled bottle, but rather that Lago's only information regarding the material was the writing on the label that was apparently affixed to the bottle by Frilette, the very person whose statements required corroboration by Lago. There is no suggestion in that decision that Lago's records would not have been adequate to establish identification if Lago had actually analyzed the material or otherwise confirmed its identity, irrespective of whether the bottle was labeled. Thus, the question here is not whether the analytical chemist knew beforehand what Chen thought he had obtained, but whether the chemist herself conducted tests to prove the identity of what Chen obtained.

Nonetheless, the Board's error here was harmless in any event because Chen failed to prove his case. Chen alleged before the Board that he actually reduced to practice six compounds within the counts prior to December 9, 1992. Chen, slip op. at 59. The Board found, however, that Chen "utterly failed to explain in his brief how the evidence on which he relies as evidence of an actual reduction to practice of the subject matter of the counts 'reads on' the specific limitations required by each of the counts." Id. at 64. Moreover, the Board found that Chen did not produce any evidence establishing how Chen identified any compounds within the counts in the reaction mixtures he prepared, or even that he ever resolved any such mixtures into their component parts. Id.

The record does not indicate how, if at all, the analytical data obtained by the analytical chemists to whom Chen sent his compounds for analysis "confirm" Chen's suggested structures, containing instead only attorney arguments and conclusory

proclamations that the data are "consistent" with Chen's suggestions. Id. at 69. The Board found, in particular, that it cannot be determined from the chemists' conclusions what formed the underlying basis for their belief that the tested samples were "consistent" with the structures proposed by Chen. Indeed, as Bouchard points out, to establish "adequate" identification of the epi-route compounds, Chen relies on the same analytical techniques, namely NMR and MS, that resulted, as of July 1, 1992, in a firm (but incorrect) conclusion that a mixture of fluorotaxols had been obtained. As found by the Board, the NMR and MS spectra that Chen apparently relies on to "confirm" the structure of the compounds as compounds within the counts are capable of more than one reasonable interpretation. Id. at 75.

Finally, the Board found that "[t]here is neither evidence contemporaneous in time with Dr. Chen's notebook entries nor evidence independent of any of the inventors (Chen and Farina) which corroborates Dr. Chen's testimony concerning the alleged actual reductions to practice." Id. at 74. As noted by the Board, no witness who signed any of Dr. Chen's or any other involved researchers' notebooks testified in this proceeding, and all of the information within those notebooks therefore remains uncorroborated. Id. at 77.

As to Chen's alternative theory of conception coupled with diligence toward reduction to practice, the Board found "an even greater paucity of detail with respect to the underlying facts." Id. at 81. The Board found, in particular, that "[t]he section of Chen et al.'s brief devoted to the 'reasonable diligence' aspect of their priority case is little more than various conclusions made without regard to any underlying facts which support the conclusions made by Chen et al." Id. at 82. The Board identified the

"critical period" for diligence as running from December 8, 1992 to March 13, 1993, and found that Chen had provided "absolutely no evidence of who worked on what applications on which days for any day in the critical period." Id. at 83-84. With regard to compounds BMS-183582 and BMS-183821, the Board found the corresponding data to be unreliable, some having been replotted years later, others having inconsistent dates, some prior to the critical date and others later. Id. at 95-97, 99-103. The Board concluded that, while Chen was undoubtedly "actively engaged in synthesizing derivatives of taxol in the critical time period," his proofs do not allow for "identification of exactly what was prepared," and "[c]ompounding this problem is the absence of adequate evidence establishing how Dr. Chen and the other researchers separated the compounds allegedly produced and subsequently tested the compounds for structural determination and utility." Id. at 104.

On the basis of these and the numerous other findings of the Board, we hold that substantial evidence supports the Board's conclusion that Chen did not establish by preponderant evidence either that he actually reduced to practice the subject matter of the counts before Bouchard's effective filing date or that he conceived the subject matter of the counts before Bouchard's effective filing date and then was reasonably diligent in constructively or actually reducing the subject matter of the counts to practice in a period beginning just prior to Bouchard's effective filing date. Accordingly, we affirm the Board's decision.

#### CONCLUSION

Because the Board's decision was supported by substantial evidence and contained no errors of law, the Board did not err in concluding that Chen failed to show

(1) entitlement to the benefit of the July 1, 1992 filing date of the '261 application or the January 19, 1993 filing date of the '423 application and/or (2) sufficiently corroborated evidence of conception prior to the December 8, 1992 filing date of Bouchard's French application, followed by diligence from just prior to that date up to an actual or constructive reduction to practice of any compounds within the three counts. Moreover, the Board did not abuse its discretion by excluding hearsay and unauthenticated evidence presented by Chen. The Board's decision to award judgment to Bouchard with respect to all three counts is therefore

AFFIRMED.

# United States Court of Appeals for the Federal Circuit

03-1037  
(Interference No. 103,675)

SHU-HUI CHEN and VITTORIO FARINA,

Appellants,

v.

HERVE BOUCHARD, JEAN-DOMINIQUE BOURZAT,  
and ALAIN COMMERCON,

Appellees.

NEWMAN, Circuit Judge, dissenting in part.

I agree that Chen is not entitled to the filing date of either the '423 or the '261 application, for these specifications do not name or picture or describe the cyclopropataxol compound of the counts, or recognize that this compound is inherently present. Accepting that the compound is in fact formed by the procedure there used, the content of these applications does not establish priority to the counts directed to the cyclopropataxol compounds.

However, the deficiencies of the first two applications are irrelevant to the '819 application, wherein the correctly identified cyclopropataxol compound was made, described, pictured, and claimed. That application is a constructive reduction to practice of the counts. Its filing date, however, is after the effective date of the party Bouchard,

requiring Chen to prove conception and either actual reduction to practice or diligence to his filing date. I do not agree that those proofs were not met by a preponderance of evidence.

Chen's conception of the cyclopropataxol of the counts, and the extensive documentary and testimonial evidence of its synthesis, identification, analysis, and biological activity, were presented and documented in a straightforward manner, in accordance with standard laboratory practices and scientific protocols. The Board abused its discretion in refusing to admit the research notebooks of Chen's assistant Jianmei Wei. The Board excluded the notebooks on the basis that they were hearsay and not within the business records exception to the hearsay rule. The Board held, citing Fed. R. Evid. 803(6), that Chen was required to prove that the notebooks were

made at or near the time by, or from information transmitted by, a person with knowledge, if kept in the course of regularly conducted business activity, and if it was the regular practice of that business activity to make the memorandum, report, record or data compilation, all as shown by the testimony of the custodian or other qualified witness, unless the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Board Op. at 52 (emphasis by the Board). There can be no dispute that Chen satisfies the criteria of a "qualified witness," under Rule 803(6), or that it was the regular practice to keep research notebooks. See Air Land Forwarders, Inc. v. United States, 172 F.3d 1338, 1344 (Fed. Cir. 1999) (where additional guarantees of reliability were present, the business records "were properly admitted by the trial court even though the government did not produce a witness that could testify with first-hand knowledge as to the procedures used in the original preparation of each of the repair estimates"); Conoco v. Department of Energy, 99 F.3d 387, 391 (Fed. Cir. 1996) ("Courts have made clear, however, that the

'custodian or other qualified witness' who must authenticate business records need not be the person who prepared or maintained the records, or even an employee of the record-keeping entity, as long as the witness understands the system used to prepare the records."). Chen testified that the notebooks were those of Ms. Wei, that he supervised her work and reviewed the notebooks, and that the information sought to be admitted was timely recorded. The Board erred in refusing to consider Chen's testimony on the ground that it was not corroborated. Not every aspect of an inventor's testimony requires corroboration.

As authority, the Board cited Holmwood v. Sugavanam, 948 F.2d 1236 (Fed. Cir. 1991). But Holmwood does not stand for the proposition that an inventor's testimony as to the authenticity of a business document must be corroborated. I can find no case that holds an inventor's testimony must be corroborated as to such routine matters as the maintenance of business records, nor does the panel majority cite to one. See id. at 1239 ("only an inventor's testimony needs corroboration"); Conoco, 99 F.3d at 391 ("Because of the general trustworthiness of regularly kept records and the need for such evidence in many cases, the business records exception has been construed generously in favor of admissibility.") The panel majority ignores this precedent, requiring that the operator of the research laboratory provide evidence of its policies concerning research notebooks. Indeed, one can always dream up testimony that might have been provided, had the PTO required it. The issue, however, is the sufficiency of what was actually provided.

The requirement that inventor testimony be corroborated arose from recognition of a combination of human frailty and faltering memory, exacerbated by the high stakes of the priority contest. These concerns apply to the acts that are presented to prove conception

and reduction to practice. They do not apply to such routine matters as whether notebooks are kept, and to require corroboration of everything to which an inventor testifies, simply because he is an inventor, amounts to the establishment of a rebuttable presumption of dishonesty. See Kridl v. McCormick, 105 F.3d 1446, 1451 (Fed. Cir. 1997) ("While there must generally be corroboration of an inventor's testimony of conception of his or her invention, the utility of the invention need not always be explicitly corroborated."). See also Ethicon, Inc. v. United States Surgical Corp., 135 F.3d 1456, 1464 (Fed. Cir. 1998) ("Accordingly, there need not be corroboration for every factual issue contested by the parties."). We should not ratify the Board's erroneous application of the rules of evidence and of precedent.

Bouchard's motion to suppress the Wei notebooks was filed in August, 2000, almost four years after the deadline of November 13, 1996 that the APJ had set for filing such motions. Chen points out that permitting this tardy objection, after the record had closed, prevented him from presenting additional evidence of the notebooks' authenticity. In failing to apply its own rules, the Board committed seriously prejudicial error.

There was no evidence whatsoever that the notebooks were not those of Ms. Wei, or that they were inaccurate or falsified or in any way unreliable. The Board has simply imposed a new evidentiary rule upon inventors and done it in a way that is manifestly unfair. Ms. Wei's notebooks were business records, and were qualified for admission into evidence; it is not necessary that the "custodian" of business records testify when the records are credibly and reasonably authenticated. Further, a motion to suppress such evidence as unauthenticated must be timely made, not withheld until after the evidentiary record has closed and it is too late to remedy any technical flaw.

The persons who performed the many analyses reasonably, and correctly, confirmed the proposed structure. The Board departed from its own rules of interference evidence in requiring corroboration of the testimony of the non-inventor analytical scientists. Further, confirmation of the structure of this complex molecule by the analysts need not exclude knowledge of the inventor's proposed structure, and I agree with the panel majority that the Board's requirements exceeded accepted and reasonable scientific procedure.

When the evidence presented to the Board is properly admitted and considered, Chen easily established conception and actual reduction to practice before the effective filing date of the party Bouchard. From the court's contrary holding, I respectfully dissent.

**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER**

1300 I Street, N.W., Suite 700  
Washington, D.C. 20005-3315

**FAX ROOM**  
**(202) 408-4174**

**(202) 408-4000**

**FACSIMILE**  
**(202) 408-4400**

**FACSIMILE TRANSMITTAL SHEET**

**Subject:** Serial No. 08/477,518      **Date:** June 19, 1997

**Client/Matter No.:** 03806-0046-01000      **Submitted by:** Judy La Follette

**TO:**

Name: Exam. Laura Cross

Name: Bryan C. Diner, Esquire

Firm: US Patent & Trademark Office

No. of Pgs. (Incl. this page): 6

Telephone No.: (703) 308-4539

Attorney Approval: BCD

Fax No.: (703) 308-7924

---

IF THERE ARE PROBLEMS WITH THIS TRANSMISSION, PLEASE NOTIFY  
THE FAX ROOM AT THE FOLLOWING NUMBER (202) 408-4174

**MESSAGE:**

CONFIRMATION COPY TO FOLLOW: Yes       No X

**Application of:** Hervé BOUCHARD et al.

**Serial No.:** 08/477,518

**Group Art Unit:** 1201

**Filed:** June 7, 1995

**Examiner:** L. Cross

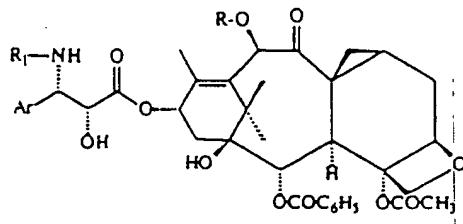
**For:** NEW TAXOIDS, THEIR PREPARATION AND  
PHARMACEUTICAL COMPOSITIONS CONTAINING THEM

---

This facsimile is intended only for the individual to whom it is addressed and may contain information that is privileged, confidential or exempt from disclosure under applicable law. If you have received this facsimile in error, please notify us immediately by telephone (collect), and return the original message to us at the above address.

COUNT 1

A taxoid of the formula:



in which

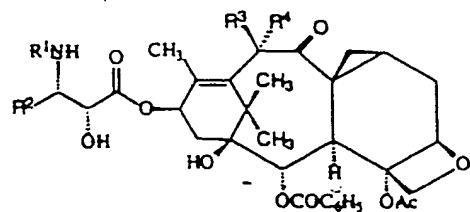
R represents hydrogen or acetyl,

R<sub>1</sub> represents benzoyl or R<sub>2</sub>-O-CO- in which R<sub>2</sub> represents t-butyl, and

Ar represents phenyl or α- or β-naphthyl, said phenyl or naphthyl being unsubstituted or substituted by C<sub>1-4</sub> alkyl, C<sub>1-4</sub> alkoxy, halogen, or CF<sub>3</sub>, or Ar represents 2- or 3-thienyl or 2- or 3-furyl, said thienyl or furyl being unsubstituted or substituted by halogen,

OR

A compound of the formula



in which

R<sup>1</sup> is -COR<sup>2</sup> in which R<sup>2</sup> is t-butyloxy, C<sub>1-6</sub> alkyl, C<sub>2-6</sub> alkenyl, C<sub>2-6</sub> alkynyl, C<sub>3-6</sub> cycloalkyl, or phenyl, optionally substituted with one to three same or different C<sub>1-6</sub> alkyl, C<sub>1-6</sub> alkoxy, halogen or -CF<sub>3</sub> groups;

R<sup>2</sup> is C<sub>1-6</sub> alkyl, C<sub>1-6</sub> alkenyl, C<sub>2-6</sub> alkynyl, C<sub>3-6</sub> cycloalkyl, or a radical of the formula -W-R<sup>3</sup> in which W is a bond, C<sub>2-6</sub> alkenediyl, or -(CH<sub>2</sub>)<sub>t</sub>-, in which t is one to six; and R<sup>3</sup> is naphthyl, furyl, thienyl or phenyl, and furthermore R<sup>3</sup> can be optionally substituted with one to three same or different C<sub>1-6</sub> alkyl, C<sub>1-6</sub> alkoxy, halogen or -CF<sub>3</sub> groups; and

R<sup>3</sup> is OCOR, -OCOOR, H, or OH; R<sup>4</sup> is hydrogen; or R<sup>3</sup> and R<sup>4</sup> jointly form a carbonyl group; and R is C<sub>1-6</sub> alkyl.

The claims of the parties which correspond to count 1 are:

Chen et al.: Claims 1-6, 8 and 9

Bouchard et al.: Claim 140

COUNT 2

$4\alpha$ - $10\beta$ -diacetoxy- $2\alpha$ -benzoyloxy- $5\beta$ , $20$ -epoxy- $18$ -hydroxy- $7\beta$ , $8\beta$ -methylene- $9$ -oxo- $19$ -nor- $11$ -taxen- $13\alpha$ -yl(2R,3S)-3-tert-butoxycarbonylamino- $2$ -hydroxy- $3$ -phenylpropionate

OR

N-debenzoyl-N-t-butoxycarbonyl-7-deoxy-8-desmethyl-7,8-cyclopropataxol.

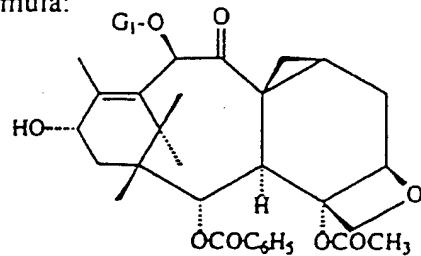
The claims of the parties which correspond to count 2 are:

Chen et al.: Claims 7-9

Bouchard et al.: Claim 142

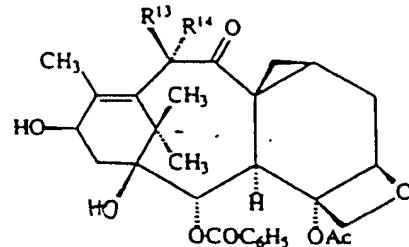
COUNT 3

A taxoid of the formula:

in which  $G_1$  represents hydrogen or acetyl,

OR

A compound of the formula:

in which  $R^{13}$  is hydrogen, acetoxy or hydroxy;  $R^{14}$  is hydrogen; or  $R^{13}$  and  $R^{14}$  jointly form a carbonyl group.

The claims of the parties which correspond to count 3  
are:

Chen et al.: Claims 10 and 11

Bouchard et al.: Claim 141

Mary F. Downey  
MARY F. DOWNEY  
Administrative Patent Judge  
(703) 308-9797

<b>Office Action Summary</b>	Application No. <b>08/477,518</b>	Applicant(s) <b>Bouchard et al</b>
	Examiner <b>Laura Lutz</b>	Group Art Unit <b>1201</b>

Responsive to communication(s) filed on Jun 28, 1996

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1, 5, 13, 24, 30, 50, 54, 62, 73, 79, 80, 105, 106, 109, 114, 117 is/are pending in the application.

Of the above, claim(s) 30, 105, 106, 109, and 114 is/are withdrawn from consideration.

Claim(s) 1, 13, 50, 62, 79, 80, and 125 is/are allowed.

Claim(s) 5, 24, 54, 73, 117, 136, 142, 143, and 145 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

125, 136, 142, 143 + 145

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) 08/162,984.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1201

Claims 1, 5, 13, 24, 30, 50, 54, 62, 73, 79, 80, 105, 106, 109, 114, 117, 125, 136, 142, 143 and 145 are pending in the application. Claims 30, 105, 106, 109 and 114 are non-elected. Claims 5, 13, 24, 54, 62, 73, 117, 125, 136, 142, 143 and 145 are rejoined with the elected claims 1, 50, 79 and 80. All cited references have been considered, and any cited but not applied are cited to show the state of the art.

Applicants faxed a copy of the claims remaining in US application serial number 08/162,984 which is subject to an interference with US 5,254,580. From that, it is clear that there is no overlapping subject matter between the claims herein and those of the interference which was the reason for the suspension of prosecution in the instant case.

***Allowable Subject Matter***

1. Claims 1, 13, 50, 62, 79, 80 and 125 are allowable over the prior art of record.

***Claim Rejections - 35 USC § 112***

2. Claims 5, 24, 54, 73, 117, 136, 142, 143 and 145 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the

---

word "optionally" when referring to the steps in the process (the language "optionally substituted" is acceptable) and it is not clear when such a step is to be carried out.

Additionally, claims 143 and 145 recited "such as" and "preferably." These phrases render

Art Unit: 1201

the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

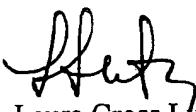
3. In claim 143, page 140 "portion" is spelled "portoin." In claim 145, page 142, lines 5-6 are awkward as written. It is suggested that one or both occurrences of "said" are deleted.
4. Claim 136 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites, at page 134 line 3, "or of an activated derivative of this acid" referring to formula XXVI. The specification does not describe what is encompassed by "activated derivative" nor how one skilled in the art would arrive at the group. As such, the language does not enable one to use the invention of claim 35 as claimed.

---

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Lutz whose telephone number is (703) 308-4539.

Art Unit: 1201

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Laura Cross Lutz  
5 August 1997

  
Johann Richter  
SPE Art Unit 1201

<b>Notice of References Cited</b>		Application No.	Applicant(s)		
		08/477,518	Bouchard et al		
Examiner	Laura Lutz		Group Art Unit	1201	Page 1 of 1

**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,532,388	7-2-96	Bouchard et al	549	510
B	5,294,637	3-15-94	Chen et al	514	449
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
T						

**NON-PATENT DOCUMENTS**

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

**INFORMATION DISCLOSURE CITATION**

(Use several sheets if necessary)

Atty. Docket No. 3806-0046-01000	Serial No. 08/477,518
<b>Applicant</b>	
Hervé BOUCHARD et al.	
<b>Filing Date</b> June 7, 1995	<b>Group</b> Unassigned

**U.S. PATENT DOCUMENTS**

**FOREIGN PATENT DOCUMENTS**

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

Guérinne-Voegelein et al., "Relationships between the Structure of Taxol Analoques and Their Antimitotic Activity," J. Med. Chem. 1991, 34, 992-998  
Klein et al., "Synthesis of Ring B-Rearranged Taxane Analogs," J. Org. Chem. 1994, 59, 2370-2373

Examiner

Date Considered

8121/96

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**Chronology of Dates from Prosecution of Bouchard's U.S. Application  
Serial No. 08/162,984, *Chen v. Bouchard*, Interference No. 103,675,  
including Chen's subsequent appeal to the C.A.F.C.**

12/08/1993 – Application entitled "New Taxoids, Their Preparation and Pharmaceutical Composition" is filed.

12/23/1993 – Transmittal of Priority Document 92 14813.

02/25/1994 – Official Filing Receipt received. Application is given Serial No. 08/162,984.

03/01/1994 – Notice of Recordation of Assignment Document.

03/15/1994 – Change of Address.

08/23/1994 – Office Action [Paper No. 7] listing pending and cancelled claims as well as those claims subject to restriction requirement.

10/04/1994 – Amendment and Request for Institution of an Interference Under 37 C.F.R. § 1.607.

10/18/1994 – Preliminary Amendment.

11/22/1994 – Response to August 23, 1994, Restriction Requirement.

11/30/1994 – Change of Address.

12/07/1994 – Duplicate copy of 11/22/1994 Restriction Requirement facsimiled to Examiner Trinh.

12/21/1994 – Information Disclosure Statement.

12/29/1994 – Letter concerning August 23, 1994 [Paper No. 7] Office Action.

12/29/1994 – Communication requesting consideration of Remarks and Declaration of François Lavelle.

12/29/1994 – Supplemental Preliminary Amendment.

12/30/1994 – Office Action [Paper No. 15] listing pending claims and those subject to restriction requirement.

01/23/1995 – Office Action [Paper No. 18] listing pending claims and those subject to restriction requirement.

01/24/1995 – Second Supplemental Preliminary Amendment.

02/23/1995 – Revocation of Prior Power of Attorney and Appointment of New Power of Attorney (Finnegan Henderson et al.) by Assignee of Entire Interest.

03/14/1995 – Communication from P.T.O. presumably accepting Power of Attorney (document is unclear).

03/14/1995 – Request for Interview.

03/22/1995 – Remailing of 03/14/1995 Communication (document is marked).

04/13/1995 – Examiner Interview Summary Record

04/20/1995 – Petition for Extension of Time (2 months) and Amendment and Request that an Interference be Declared Under Rule 607.

04/27/1995 – Submission of Reexecuted Declaration of François Lavelle.

05/23/1995 – Office Action [Paper No. 26] listing claims pending, withdrawn and allowed.

**10/24/1995 – Declaration of Interference No. 103,675, *Chen v. Bouchard*, assigned to APJ Downey.**

10/24/1995 – Order detailing due date.

02/06/1996 – Chen Motion for Extension of Time (1 month).

02/08/1996 – Approval of Chen's Motion for Extension of Time [Paper No. 13].

03/11/1996 – Bouchard Proposed Amendment amending Claim 141 [filed concurrently with Bouchard's Preliminary Motions Nos. 1-3].

03/11/1996 – Bouchard files Preliminary Motions Nos. 1-3.

03/11/1996 – Bouchard files Preliminary Statement.

03/11/1996 – Chen files Preliminary Statement.

03/11/1996 – Chen files Preliminary Motions Nos. 1-4.

04/03/1996 – Chen files Preliminary Motion No. 5.

04/12/1996 – Bouchard files Motion for Extension of Time (1 month).

04/15/1996 – Approval of Bouchard Motion for Extension of Time [Paper No. 29].

05/23/1996 – Bouchard Oppositions to Chen Preliminary Motions Nos. 1-5.

05/31/1996 – Chen Motion for Extension of Time (1 month).

06/07/1996 – Approval of Chen's Motion for Extension of Time [Paper No. 37].

07/08/1996 – Chen files Reply Nos. 1-5.

07/16/1996 – Bouchard Motion to Strike No. 1 Under 37 C.F.R. § 1.635.

08/05/1996 – Chen Opposition to Bouchard's Motion to Strike No. 1.

08/08/1996 – Bouchard Reply to Motion to Strike No. 1.

08/19/1996 – Withdrawal of Chen Preliminary Motion No. 2.

08/22/1996 – **Decision on Motions** [Paper No. 53].

08/22/1996 – Order detailing testimony and testimony period [Paper No. 54].

09/05/1996 – Bouchard Request for Reconsideration No. 1.

09/10/1996 – Bouchard Paper Under 37 C.F.R. § 1.640(b).

09/10/1996 – Bouchard Reliance on Preliminary Statement.

09/11/1996 – Chen Statement Under 37 C.F.R. § 1.640(b).

09/11/1996 – Chen Preliminary Statement.

09/11/1996 – Chen Supplemental Preliminary Statement.

**09/11/1996 – Order denying Bouchard Request for Reconsideration [Paper No. 56].**

09/20/1996 – Bouchard Petition Under 37 C.F.R. § 1.644(a).

09/22/1996 – Bouchard Letter to APJ Downey Concerning Timing of Motions Seeking Rule 68(c) Discovery.

09/26/1996 – Chen Motion for Extension of Time (2 weeks).

10/01/1996 – Bouchard et al. Motion for Discovery No. 1.

10/01/1996 – Approved Chen et al. Motion for Extension of Time.

10/03/1996 – Chen et al. Opposition to Petition Under 37 C.F.R. § 1.644(a).

10/07/1996 – Chen et al. Opposition to Bouchard Motion for Discovery No. 1.

10/08/1996 – Bouchard et al. Motion No. 1 for Reply and [the] Reply.

10/11/1996 – Bouchard et al. Reply for Discovery No. 1.

10/16/1996 – Communication from Party Chen.

10/16/1996 – Chen et al. Opposition to "Bouchard et al. Motion No. 1 for Reply and Reply".

10/22/1996 – Bouchard et al. Reply No. 1 for Reply and Reply.

10/30/1996 – Chen Notice Under 37 C.F.R. § 1.671(e).

10/31/1996 – **Order denying Bouchard's Request for Certification [Paper No. 75].**

11/07/1996 – Bouchard et al. Request for Cross-Examination.

11/13/1996 – Bouchard et al. Objections Under Rule 672(c).

11/15/1996 – Chen et al. Notice Under 37 C.F.R. § 1673(e).

11/19/1996 – Chen et al. Motion Under 37 C.F.R. § 1.635 Telephone Conference and Entry of Order.

11/25/1996 – Bouchard et al. Opposition Under 37 C.F.R. § 1.638 to Chen et al. Motion Under 37 C.F.R. § 1.635 [for] Telephone Conference and Entry of Order.

11/26/1996 – Chen et al. Reply on Chen et al. Motion for Telephone Conference and Entry of Order.

12/03/1996 – Chen et al. Notice of Filing Supplemental Declarations and Exhibits Pursuant to 37 C.F.R. § 1.672(c).

**12/05/1996 – Decision on petition.**

12/30/1996 – Bouchard et al. Motion for Extension of Time (2 weeks).

12/31/1996 – Approval of Bouchard Motion for Extension of Time.

01/10/1997 – Bouchard et al. Request for Rebuttal Testimony.

01/15/1997 – Bouchard et al. Motion for Extension of Time (8 days).

01/15/1997 – Approval of Bouchard Request for Rebuttal Testimony Period.

01/16/1997 – Chen et al. Opposition to Bouchard et al. Motion for Extension of Time.

01/16/1997 – Bouchard et al. Substitute Motion for Extension of Time.

01/24/1997 – Order re-setting all time periods [Paper No. 92].

01/24/1997 – Bouchard et al. Motion for Further Extension of Time [Paper No. 93].

01/26/1997 – Response to Communication Regarding Bouchard et al.'s Supplement to Discovery Motion 1.

01/28/1997 – Order clarifying current due dates [Paper No. 94].

02/25/1997 – Supplement to Bouchard et al. Motion for Discovery No. 1.

02/25/1997 – Communication from Chen et al. Regarding Bouchard et al.'s Supplement to Discovery Motion No. 1.

03/03/1997 – Bouchard et al. Notice Under 37 C.F.R. § 1.671(e).

03/03/1997 – Bouchard et al. Notice of Reliance.

03/03/1997 – Bouchard et al. Notice Under 37 C.F.R. § 1.672(b).

03/03/1997 – Letter Concerning Filing of Original Bouchard Exhibits.

03/11/1997 – Order re: Discovery Motion [Paper No. 100].

03/18/1997 – Chen Paper Regarding Bouchard et al. Supplement Discovery Motion No. 1.

03/25/1997 – Bouchard et al. Notice Under 37 C.F.R. § 1.672(b).

03/25/1997 – Bouchard et al. Notice of Reliance.

01/25/1997 – Bouchard et al. Letter Concerning Filing of Original Exhibits of Party.

03/25/1997 – Bouchard et al. Response to Order in Paper No. 100.

03/25/1997 – Bouchard et al. Response to Chen Paper Regarding Bouchard et al. Supplement to Motion for Discovery No. 1.

03/31/1997 – Chen et al. Index of Deposition Transcripts (Pursuant to 37 C.F.R. § 1.672(d)).

03/31/1997 – Chen et al. Index of Deposition Exhibits (Pursuant to 37 C.F.R. § 1.572(d)).

04/01/1997 – Chen et al. Reply to Bouchard's Response to Paper No. 100.

04/09/1997 – Chen et al. Discovery Motion No. 1.

04/09/1997 – Chen et al. Motion for Extension of Time (11 days).

04/14/1997 – Bouchard et al. Notice Under 37 C.F.R. § 1.673(e).

04/15/1997 – Approval of Chen et al. Motion for Extension of Time.

04/22/1997 – Bouchard et al. Opposition to Chen et al. Discovery Motion No. 1.

04/25/1997 – Chen Reply to Bouchard's Opposition to Chen Discovery Motion No. 1.

05/16/1997 – Bouchard et al. Request No. 2 for Reconsideration.  
– Bouchard et al.'s Request for Reconsideration No. 3.

06/05/1997 – Chen's Response to Bouchard's Request No. 2 for Reconsideration.

06/30/1997 – Bouchard et al. Index of Deposition Transcripts Under 37 C.F.R. § 1.672(d).

06/30/1997 – Bouchard et al. Index of Deposition Exhibits Under 37 C.F.R. § 1.672(d).

07/02/1997 – Bouchard et al. Motion Under Seal for In Camera Inspection and Non-Production [Filed under seal].

07/02/1997 – Filing of Privileged Document Log and Notice of Filing of Motion for In Camera Inspection and Non-Production.

07/11/1997 – Bouchard Letter Concerning Filing Replacement Motion for In Camera Inspection.

07/15/1997 – Replacement Motion for In Camera Inspection and Non-Production.

07/25/1997 – Chen Opposition to Bouchard's Replacement Motion for In Camera Inspection and Non-Production.

07/28/1997 – Reply to Chen's Opposition to Bouchard's Replacement Motion for In Camera Inspection and Non-Production.

07/28/1997 – Party Bouchard Letter.

**\*03/17/1998 – Filing date of Bissery application ('789 patent)-U.S. Application Serial No. 09/042,992**

**02/24/1999 – Redeclaration of Interference [Paper No. 30].**

03/17/1999 – Communication from APJ Downey concerning initial due dates [Paper No. 159].

03/19/1999 – Party Hester Motion to Add Claims 46 and 47.

03/22/1999 – Party Bouchard Submission of Clean Copy of Claims.

03/31/1999 – Chen Request for Copies of Files.

03/31/1999 – Chen Copies of Claims.

03/31/1999 – Hester Request for Copies.

03/31/1999 – Hester Clean Copy of Claims.

04/16/1999 – Bouchard's Renewed Request for Copies.

04/19/1999 – Bouchard Communication re: Renewed Request for Copies.

04/28/1999 – Bouchard's Request for Missing File Papers.

07/09/1999 – Order (concerning service of Parties preliminary statements and prior-filed papers along with due date for motions, oppositions and replies) [Paper No. 179].

07/09/1999 – Redeclaration (of interference) [Paper No. 31].

07/14/1999 – Hester Notification of Date for Filing Preliminary Statement.

08/16/1999 – Hester Preliminary Statement.

08/20/1999 – Party Bouchard et al. Notice of Service of Preliminary Statement.

08/20/1999 – Chen Notice of Service of Preliminary Statement.

08/23/1999 – Hester Request for Copies.

08/27/1999 – Party Bouchard et al. Notice of Service of Motions, Oppositions and Replies Filed During Preliminary Motions Period.

08/27/1999 – Chen Notice of Service of Preliminary Motions, Oppositions and Replies.

09/01/1999 – Joint Motion No. 1 to Substitute New Count 4 for Count 1.

09/21/1999 – Hester Request for Missing File Papers.

10/04/1999 – Party Bouchard et al. Unopposed Motion for Extension of Time (2 weeks).

10/18/1999 – Approval of Party Bouchard Unopposed Motion for Extension of Time.

10/28/1999 – Party Bouchard et al. Second Unopposed Motion for Extension of Time (2 weeks).

10/29/1999 – Order (granting parties Joint Motion to Substitute New Count 4 for Count 1) [Paper No. 192].

**10/29/1999 – Redeclaration of Interference [Paper No. 32].**

11/12/1999 – Bouchard Preliminary Motion No. 6.

11/12/1999 – Bouchard Preliminary Motion No. 7.

11/12/1999 – Bouchard Preliminary Motion No. 8.

11/12/1999 – Exhibits to Bouchard Preliminary Motions 6-8 and Declarations of Commercon, Lavelle Parker

11/12/1999 – Chen Preliminary Motion 6.

11/12/1999 – Chen Preliminary Motion 7.

11/12/1999 – Chen Preliminary Motion 8.

11/12/1999 – Chen Preliminary Motion 9.

11/12/1999 – Chen Preliminary Motion 10.

11/12/1999 – Chen Letter Regarding Deferred Preliminary Motions.

11/12/1999 – Chen Transmittal for Developing Record and Exhibits.

11/12/1999 – Exhibits to Chen's Preliminary Motions 6-10 and [Filed in Folders Behind Pleadings, Volume XI, so marked].

11/18/1999 – Bouchard Letter Regarding Deferred Preliminary Motions.

11/18/1999 – Bouchard Notice of Transmittal and Service of Exhibits, Declarations, Depositions Pages, Certified Translation of Bouchard's French Priority Application No. 92 14813.

11/29/1999 – Hester Motion for Extension of Time (1 month).

01/03/2000 – Hester Responsive Motion No. 1.

01/03/2000 – Chen Second Letter Regarding Deferred Preliminary Motions.

01/07/2000 – Letter from Michael R. Weiner, Esq. (Counsel for Hester) to Carolyn Whitfield (paralegal to Judge Downey) of Board of Patent Appeals and Interferences.

01/07/2000 – Bouchard Letter Responding to Chen Second Letter Regarding Deferred Preliminary Motions.

01/18/2000 – Bouchard Notice Pursuant to 37 C.F.R. § 1.602(c).

**01/31/2000 – Order (reformulation of existing interference and declaration of two additional interferences 104,490-Chen v. Hester and 104,491-Hester v. Bouchard [Paper No. 227].**

02/01/2000 – Redeclaration of Interference (to *Chen v. Bouchard*) [Paper No. 12].

02/10/2000 – Bouchard et al. Motion to Withdraw Bouchard et al. Request for Reconsideration No. 3.

02/10/2000 – Bouchard et al. Motion for Discovery No. 2.

02/14/2000 – Bouchard Paper Listing Matters for Discussion During February 28, 2000 Conference Call.

02/14/2000 – Bouchard et al. Motion to Reopen Testimony.

02/14/2000 – Bouchard Renewed Opposition to Chen Preliminary Motions Nos. 1 and 5.

02/14/2000 – Chen Letter Regarding Discovery and Testimony.

02/18/2000 – Order.

02/25/2000 – Paper from Board Returning Bouchard Renewed Opposition to Chen Preliminary Motions 1 and 5 [Paper No. 243].

03/03/2000 – Bouchard et al. Letter Detailing Production.

03/03/2000 – Submission of Transcript of 24 February, 2000 Conference Call.

03/06/2000 – Supplement to Bouchard et al. Motion to Reopen Testimony.

03/06/2000 – Bouchard Motion Under 37 C.F.R. § 1.635 for Leave to File a Belated Motion for Judgment Under 37 C.F.R. § 1.635.

03/06/2000 – Bouchard Preliminary Motion No. 9.

03/06/2000 – Bouchard Motion Under 37 C.F.R. § 1.635 Requesting the Administrative Patent Judge to Enter and Order Under 37 C.F.R. § 1.641(a).

03/06/2000 – Bouchard Preliminary Motion No. 10.

03/06/2000 – Bouchard Letter Regarding Compliance with February 18, 2000 Discovery Order.

03/06/2000 – Bouchard Letter Regarding Exhibits 123-169 and Accompanying Declarations.

03/06/2000 – Submission of Transcript of February 24, 2000 Conference Call.

03/07/2000 – Letter to APJ Downey from Counsel for Hester Pursuant to Her Request During March 6, 2000 Conference Call.

03/10/2000 – Bouchard Letter Regarding Declarations and Exhibits Associated with Bouchard Previously Filed Motion to Reopen Testimony.

03/15/2000 – Chen Opposition to Bouchard Discovery Motion 2.

03/16/2000 – Letter from APJ Downey Concerning 6 March, 2000 Conference Call and Materials to be Returned to Parties

03/20/2000 – Chen Opposition to Bouchard Motion to Reopen Testimony 1.

03/27/2000 – Chen Motion for Extension of Time (2 wks).

04/10/2000 – Chen Opposition to Bouchard Motion to Reopen.

04/10/2000 – Chen Opposition to Bouchard Belatedness Motion.

04/10/2000 – Chen Opposition to Bouchard Motion Under 37 C.F.R. § 1.641(a).

04/10/2000 – Chen Motion re Bouchard Preliminary Motion 10.

04/10/2000 – Chen Motion for Extension of Time (not ruled upon).

04/11/2000 – Bouchard Reply to Chen Opposition to Bouchard Motion to Reopen Testimony.

04/11/2000 – Bouchard Reply to Chen Opposition to Bouchard Discovery Motion No. 2.

04/11/2000 – Bouchard Opposition to Chen Motion for Extension of Time .

04/14/2000 – Reply of the Junior Party Chen et al. in Support of Its Motion Under 37 C.F.R. §§ 1.635 and § 1.645 for an Extension of Time.

**04/25/2000 – Decision on Various Bouchard Motions [Paper No. 269].**

04/28/2000 – Bouchard Letter Regarding Replies for Bouchard's Good Cause Motion, Bouchard's 641(a) Motion and Bouchard's Supplemental Motion to Reopen.

04/28/2000 – Bouchard Reply to Chen Opposition to Bouchard Belatedness Motion.

04/28/2000 – Bouchard Reply to Chen Opposition to Bouchard Motion Under 37 C.F.R. § 1.641(a).

04/28/2000 – Bouchard Reply to Chen Opposition to Bouchard Motion to Reopen Testimony 2.

05/01/2000 – Bouchard Opposition to Chen Motion re Bouchard Preliminary Motion 10.

05/12/2000 – (Bouchard) Submission of Transcript of April 27, 2000 Conference Call.

05/09/2000 – Bouchard Letter Concerning Potential Request for Reconsideration of the APJ's April 25, 2000 Order.

05/23/2000 – Chen Motion for Extension of Time (2 month).

05/24/2000 – Approval of Chen Motion for Extension of Time [Paper No. 277].

06/23/2000 – Senior Party Bouchard Principal Brief on Preliminary Motions.

06/23/2000 – Senior Party Bouchard Principal Brief on Priority.

06/23/2000 – Senior Party Bouchard Notice of Service of Record.

06/23/2000 – Chen Motions Brief.

06/23/2000 – Chen Priority Brief.

**07/11/2000 – Order Denying Various Bouchard Motions [Paper No. 284].**

08/04/2000 – Bouchard Opposition to Chen Priority Brief.

08/04/2000 – Bouchard Opposition to Chen Proposed Findings of Fact and Conclusions of Law for Priority Brief.

08/04/2000 – Bouchard Opposition to Chen Motions Brief.

08/04/2000 – Bouchard Opposition to Chen Proposed Findings of Fact and Conclusions of Law for Chen Motions Brief.

08/04/2000 – Bouchard Motion to Suppress Evidence.

08/04/2000 – Chen Opposition to Bouchard Priority Brief.

08/04/2000 – Chen Opposition to Bouchard Motions Brief.

08/04/2000 - Chen Motion to Suppress.

08/10/2000 - Bouchard Motion Under 37 C.F.R. § 1.635 for Leave to File a Supplemental Motion to Suppress Evidence Under 37 C.F.R. § 1.656(h).

08/10/2000 - Bouchard Supplemental Motion to Suppress Evidence.

08/30/2000 - Chen Opposition to Bouchard Belatedness Motion 2 Bouchard Reply to Chen Opposition to Bouchard Priority Brief.

09/07/2000 - Bouchard Reply to Chen Opposition to Bouchard Motions Brief.

09/07/2000 - Bouchard Opposition to Chen Motion to Suppress.

09/07/2000 - Chen Priority Reply Brief.

09/07/2000 - Chen Reply re Proposed Findings of Fact and Conclusions of Law for Priority Brief.

09/07/2000 - Chen Motions Reply Brief.

09/07/2000 - Chen Reply re Proposed Findings of Fact and Conclusions of Law for Motions Brief.

09/07/2000 - Chen Opposition to Bouchard Motion to Suppress.

09/14/2000 - Bouchard Reply to Chen Opposition to Bouchard Motion for Leave to File a Supplemental Motion to Suppress Evidence.

09/26/2000 - Chen Reply re Motion to Suppress.

09/26/2000 - Bouchard Reply to Chen Opposition to Bouchard Motions to Suppress.

10/02/2000 - Letter Concerning the Filing of the Record of Bouchard et al.

10/02/2000 - Chen Letter Transmitting Record and Exhibits.

10/25/2000 - Chen Motion to Suppress 2.

11/02/2000 - Bouchard Opposition to Chen Motion to Suppress 2.

11/17/2000 - Chen Reply to Motion to Suppress 2.

12/04/2000 - **Order Transferring Interference (to Judge Andrew H. Metz) [Paper No. 311].**

\*12/15/2000 - **Issuance of Bissery Patent-U.S. Patent 6,156,789**

02/03/2001 – Order (concerning date and details of final hearing).

02/13/2001 – Bouchard Notice Regarding Final Hearing.

**\*03/21/2001 – Filing date of Bissery application ('026 patent)-U.S. Application Serial No. 09/813,018**

04/20/2001 – Bouchard Second Motion Under 37 C.F.R. § 1.635 to File a Belated Motion for Judgment Under 37 C.F.R. § 1.633(a).

04/20/2001 – Bouchard Preliminary Motion 11 (for judgment based on equitable conduct and for discovery).

04/27/2001 – Order [Paper No. 315].

05/02/2001 – Chen Notice of Intention to Attend Final Hearing.

05/03/2001 – Chen Opposition to Bouchard Second Motion Under 37 C.F.R. § 1.635 for Leave to File a Belated Motion for Judgment Under 37 C.F.R. § 1.633(a).

05/03/2001 – Chen Opposition to Bouchard Preliminary Motion No. 11.

05/07/2001 – Bouchard Paper Listing Persons Attending Final Hearing.

05/08/2001 – Bouchard Reply to Chen Opposition to Bouchard Second Motion Under 37 C.F.R. § 1.635 for Leave to File Belated Motion for Judgment Under 37 C.F.R. § 1.633(a).

05/08/2001 – Bouchard Reply to Chen Opposition to Bouchard Preliminary Motion 11.

05/11/2001 – Order [Paper No. 329].

05/11/2001 – Bouchard Notice Regarding Raising Inequitable Conduct at May 16, 2001, Final Hearing and Filing Supplemental Record.

05/11/2001 – Hester Notice of Attendance at Final Hearing.

05/14/2001 – Chen List of Attendees for Final Hearing.

05/11/2001 – Supplemental to Bouchard Notice Regarding Inequitable Conduct at Hearing and Filing Supplemental Record.

05/16/2001 – Notice of Recordation of Assignment Document (found in Bouchard's '984 application file)

05/22/2001 – Bouchard Request for Reconsideration No. 4.

08/02/2002 – Final Decision [Paper No. 336].

08/06/2002 – Order [Paper No. 337].

\*08/37/2002 – **Issuance of Bissery Patent-U.S. Patent 6,441,026.**

09/26/2002 – Chen's Letter to the Clerk of the United States Court of Appeals for the Federal Circuit transmitting Chen's Notice of Appeal.

09/26/2002 – Chen's Notice of Appeal to the United States Court of Appeals for the Federal Circuit.

10/09/2002 – Notification from Board Concerning Non-Notification of 35 U.S.C. § 146 Action [Paper No. 338].

10/21/2002 – Bouchard's Status Update.

10/21/2002 – Chen Response to October 9, 2002 Paper.

09/26/2002 – Notice of Appeal to the United States Court of Appeals for the Federal Circuit.

09/24/2002 – Official Caption of case (also includes authorized abbreviated caption).

09/26/2002 – Counsel for Chen Letter to the Clerk of the United States Court of Appeals for the Federal Circuit transmitting Chen's Notice of Appeal.

09/27/2002 – Date-stamped copy of Notice of Appeal to the United States Court of Appeals for the Federal Circuit (includes official stamp of Appeal Number 03-1037).

10/17/2002 – Notice Forwarding Certified List (to the Court of Appeals for the Federal Circuit) [Notice includes copy of certified list].

10/24/2002 – Notice of Docketing.

11/19/2002 – Revised Official Caption.

12/16/2002 – Appellants' Consent Motion to Extend Time for Filing Appellant's Brief.

12/17/2002 – Order granting Chen's Motion for Extension of Time to file initial brief.

01/06/2003 – Chen Principal Appeal Brief.

02/06/2003 – Appellee's Consent Motion to Extend Time for Filing Appellee's Brief.

02/07/2003 – Order (granting Appellee's Consent Motion to Extend Time for Filing Appellee's Brief)

03/03/2003 – Brief of Appellees Herve Bouchard, Jean-Dominique Bourzat, and Alain Commercon.

03/11/2003 – Appellants' Consent Motion to Extend Time for Filing Appellants' Reply Brief.

03/11/2003 – Chen's Letter to the Clerk of Court transmitting Appellants' Consent Motion to Extend Time for Filing Appellants' Reply Brief.

03/11/2003 – Order Granting Chen's Consent Motion to Extend Time for Filing Appellant's Reply Brief.

04/10/2003 – Reply Brief of Appellants Shu-Hui Chen and Vittorio Farina.

04/10/2003 – Joint Statement of Compliance with Federal Circuit Rule 33.

04/10/2003 – Letter to Clerk of the C.A.F.C. from Chen transmitting Joint Statement of Compliance with Federal Circuit Rule 33.

04/11/2003 – Notice from Court.

04/30/2003 – Appellants' Citation of Supplemental Authority Under Rule 28(h) (with attachment of *Herman v. Barnes v. Herman*, Interference No. 104,812 (Bd. Pat. App. & Int. April 10, 2003)).

04/30/2003 – Letter to the Clerk of the Court transmitting Appellants' Citation of Supplemental Authority.

05/06/2003 – Appellees' Response to Citation of Supplemental Authority Under Rule 28(h).

05/06/2003 – Letter to the Clerk of the Court transmitting Appellees' Response to Citation of Supplemental Authority Under Rule 28(h).

05/23/2003 – Oral Argument Order (with attached Information sheet/Notices to Counsel on Oral Argument brochure, Courtroom Decorum sheet, Oral Argument Clock sheet Calendar Announcement and pink Response to Oral Argument Order).

05/28/2003 – Appellant Chen Response to Oral Argument Order.

05/30/2003 – Appellee Bouchard Response to Oral Argument Order.

**10/22/2003 – Notice of Entry of Judgment Accompanied by Opinion [includes information sheets on Petitions for Panel Rehearing,**

**Petitions for Rehearing or Rehearing En Banc, Filing a Petition  
for Writ for Certiorari and Bill of Costs].**

10/22/2003 – Judgment (Issued as a Mandate) Affirming Judgment of the Board.

All communications respecting this case should identify it by number and names of parties.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: BOX INTERFERENCE  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Telephone: (703) 308-9797  
Facsimile: (703) 308-7953

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

~~RECORDED~~ Interference No. 103,675

MAILED

Chen et al.

AUG 22 1996

v.

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Bouchard et al.

I.

The following motions have been filed:

Bouchard et al.

Unopposed motion 1 to redefine [37 CFR 1.633(c)(1)] to substitute proposed count 3A for count 3 (Paper No. 16).

Unopposed motion 2 to redefine [37 CFR 1.633(c)(2)] to amend claim 141 to insert OH in 7th position (Paper No. 17).

Unopposed motion 3 for benefit [37 CFR 1.633(f)] of the Dec. 9, 1992 filing date of the France application for proposed count 3A (Paper No. 18).

Unopposed motion 4 for benefit [37 CFR 1.633(j) and (f)] of French Priority application No. 92 14813 for Chen proposed count 4 (Paper No. 26).

Motion 5 to strike portions of Chen reply Nos. 1 and 5 (Paper No. 49).

Interference No. 103,675

Chen et al:

Motion 1 for benefit [37 CFR 1.633(f)] of Ser. No. 07/907,261 filed July 1, 1992 and 08/006,423 filed January 19, 1993 for counts 1-3 (Paper No. 20). Opposition (Paper No. 30), Reply (Paper No. 39).

Motion 2 to redefine [37 CFR 1.633(c)(1)] to substitute count 1 for count 2 and to designate claims 1-9 and 140 and 142 as corresponding to count 1 (Paper No. 21) and a request for discovery and testimony from Bouchard and others. Opposition (Paper No. 31) Reply, (Paper No. 40).

Motion 3 to redefine [37 CFR 1.633(c)(1)] to substitute count 1 for count 3 and to designate Chen claims 1-6 and 8-11 and Bouchard claims 140 and 141 as corresponding to count 1 or in the alternative a motion to substitute count 4 (which covers genus of count 1 and compound of count 3 in alternative form) for count 3 (Paper No. 22). Opposition (Paper No. 32), Reply (Paper No. 41).

Motion 4 to attack benefit [37 CFR 1.633(g)] as to the filing date accorded Bouchard et al. in the declaration notice with respect to count 2 (Paper No. 23). Opposition (Paper No. 33), Reply (Paper No. 42).

Motion 5 for benefit [37 CFR 1.633(j) and (f)] of their earlier filed applications with respect to Bouchard et al. proposed count 3A (Paper No. 27). Opposition (Paper No. 34), Reply (Paper No. 43).

II.

DECISION ON PRELIMINARY MOTIONS

Chen et al. motions 1 and 5

In the motions, Chen et al. urge that their benefit applications inherently satisfy 35 USC 112, first paragraph with respect to the counts.

The motions are deferred to final hearing in order to allow the parties to take testimony on the issue of whether examples 3, 5 and 6 of the benefit applications produce compounds within the scope of the counts and to allow the Board to properly evaluate all the evidence submitted with the motions, oppositions and replies and the testimony taken with respect to this issue.

Bouchard et al. motion 5

In the motion, Bouchard et al. move to strike certain arguments and evidence submitted with the Chen et al. replies 1 and 5. The motion is dismissed as moot in view of the fact that the undersigned has deferred the Chen et al. motions 1 and 5 to final hearing and granted a testimony period on the issue.

Bouchard et al. Motion 1

Both Bouchard et al. and Chen recognize that count 3 contains an error. The motion is granted. The interference will be redeclared in due course to reflect the grant of this motion.

Interference No. 103,675

Bouchard et al. Motion 2

The motion is granted. The amendment to claim 141 will be entered and claim 141(as amended) will be designated as corresponding to count 3A. The interference will be redeclared in due course to reflect the grant of this motion.

Bouchard et al. Motion 3

The motion for benefit is granted.

Chen et al. motions 2

Chen et al. have withdrawn the motion and requests for discovery and testimony (Paper No. 52). Hence, the motion and requests are dismissed as moot.

Chen et al. motion 3

The motion is deferred to final hearing.

Chen et al. Motion 4

The motion to deny Bouchard et al. benefit is denied for essentially those reasons set forth in the Bouchard et al. opposition paper. Chen et al. recognize that claim 3 of the benefit application recites four compounds and one of the four compounds is the compound of count 2 (material fact #6, page 2 of motion). Hence, that limited genus of four compounds is deemed sufficient to satisfy 35 USC 112, first paragraph description requirement for the compound of count 2.

Interference No. 103,675

Bouchard et al. Motion 4

The motion is deferred to final hearing.

PRELIMINARY STATEMENTS

The preliminary statements already filed in the Patent and Trademark Office are required to be served (but not filed again) within twenty days from the date of this order.

The parties may file and serve a supplemental preliminary statement or a statement of reliance pursuant to 37 CFR 1.640(b)(1) as to new count 3A within twenty days from the date of this order.

III.

STATEMENT OF MATTERS TO BE REVIEWED  
AND/OR CONSIDERED AT FINAL HEARING

It is ordered that the parties file a paper pursuant to 37 CFR 1.640(b) as amended, by TWENTY DAYS FROM THE DATE OF THIS ORDER identifying any decisions on motions or matters raised sua sponte by the administrative patent judge that the party wishes to have reviewed at final hearing as well as identifying any deferred motions that the party wishes to have considered at final hearing.

Interference No. 103,675

Evidence Relied Upon During the Preliminary Motions Period

The parties should note that affidavit(s), declaration(s), patent(s), and publications(s) relied upon by them in connection with the preliminary motion(s) will be given no consideration at final hearing unless introduced into evidence in accordance with the rules. See 37 CFR §1.671(e) and §1.682.

Service of Papers by Hand or Express Mail

IT IS ORDERED that all papers served on opposing counsel in this interference shall be served by Express Mail (a one-day delivery service of the U.S. Postal Service) (37 CFR §1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes a one-day delivery, e.g., by hand, facsimile, or a commercial one-day delivery service.

Testimony

Times for taking testimony are set in a concurrent paper and will be conducted in accordance with the interference rules as amended effective April 21, 1995. See Notice of Final Rule, 60 FR 14488 (March 17, 1995), corrections printed in 60 FR 16920 (April 3, 1995). See also 1173 OG. 36 (April 11, 1995)

Interference No. 103,675

Exhibits

Exhibits should be identified by exhibit numbers (not letters) on a label placed in the lower right-hand corner of the first page of the exhibit. See 37 CFR §1.653(i). If important material is covered by an exhibit label on the first page of the exhibit, a copy of the first page of the exhibit may be reproduced and presented as page 1-a of the exhibit. If the exhibit is handwritten, a typed copy of the exhibit is to be attached to the exhibit. Exhibits should be labeled as follows:

Exhibit 1  
NAME OF PARTY IN CAPITAL LETTERS  
Interference No. 103,675

All original exhibits should be submitted in an accordion type or other folder containing all exhibits in numerical order.

  
\_\_\_\_\_  
Mary F. Downey  
Administrative Patent Judge  
(703) 308-9797

MFD/raj

Interference No. 103,675

Fitzpatrick, Cella, Harper & Scinto  
277 Park Avenue  
New York, NY 10172

Thomas L. Irving et al.  
Finnegan, Henderson, Farabow,  
Garrett & Dunner  
1300 I Street, N.W.  
Washington, DC 20005-3315